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Ralph E. Jocke
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December 14, 2004

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Re: **Application Serial No.:** 09/193,787
Confirmation No.: 2446
Prior Appeal No.: 2003-1651
Appellants: Jay Paul Drummond, et al.
Title: Automated Banking Machine
Apparatus and System
Docket No.: D-1077+1

Sir:

Appellants request reinstatement of their appeal. Please find enclosed the 2nd Supplemental Appeal Brief of Appellants pursuant to 37 C.F.R. § 41.37 in response to the Action dated July 28, 2004 for filing in the above-referenced application.

The Commissioner is authorized to charge any fee (\$500) required with this filing and any other fee due to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

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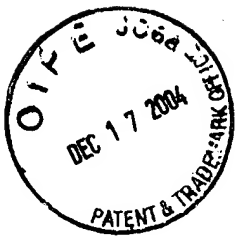
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CLEVELAND

330 • 722 • 6446
FACSIMILE

rej@walkerandjocke.com
E-MAIL

231 South Broadway, Medina, Ohio U.S.A. 44256-2601



D-1077+1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Previous Appeal No.: 2003-1651)	
)	
In re Application of:)	
Jay Paul Drummond, et al.)	Art Unit 3621
)	
Serial No.: 09/193,787)	
)	
Confirmation No.: 2446)	Patent Examiner
)	Jalatee Worjloh
Filed: November 17, 1998)	
)	
Title: Automated Banking Machine)	
Apparatus and System)	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**SECOND SUPPLEMENTAL BRIEF OF APPELLANTS
PURSUANT TO 37 C.F.R. § 41.37**

Sir:

The Appellants hereby respectfully request reinstatement of the appeal. The Appellants hereby submit their Second Supplemental Appeal Brief pursuant to 37 C.F.R. § 41.37 concerning the above-referenced Application.

12/27/2004 MHEKONEN 00000044 090428 09193787

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(i)

REAL PARTY IN INTEREST

The Assignee of all right, title and interest to the above-referenced Application is Diebold, Incorporated, an Ohio corporation.

(ii) RELATED APPEALS AND INTERFERENCES

In this application a Board decision regarding Appeal No. 2003-1651 was previously rendered on October 8, 2003. In said decision the Examiner was reversed on all issues.

Other applications (09/193,791; 09/193,564; 09/193,646; 09/193,662; 09/193,647) having been assigned appeal numbers claim priority to the parent application (09/077,337). It is believed that these other appeals do not pertain to the claimed subject matter. However, it is respectfully requested that the Board make its own determination regarding the pertinence of these other applications. The Board is also requested to check (update) the (appeal) status of other applications claiming priority to the parent application.

Appellants, Appellants' legal representative, and assignee believe that there are no additional related appeals or interferences pertaining to this matter.

(iii)

STATUS OF CLAIMS

Claims 1-30 are pending in the Application.

Claims rejected: 1-30

Claims allowed: none

Claims confirmed: none

Claims withdrawn: none

Claims objected to: none

Claims canceled: none

Appellants appeal the rejections of claims 1-30, inclusive. These rejections were the only rejections present in the Office Action ("Action") dated July 28, 2004.

(iv)

STATUS OF AMENDMENTS

No final rejection has been made. However, claims have been rejected at least four times. Therefore, no amendments to the claims were requested to be admitted after a final rejection.

The following dates and papers are associated with this application:

1. 11/05/01 First Non-final Office Action Rejection
2. 02/04/02 Applicants' Response
3. 04/16/02 Second Non-final Office Action Rejection
4. 04/23/02 Notice of Appeal
5. 06/20/02 Appeal Brief
6. 09/16/02 Third Non-final Office Action Rejection (Prosecution Reopened)
7. 01/16/03 First Supplemental Appeal Brief
8. 03/11/03 Examiner's Answer
9. 04/17/03 Reply Brief
10. 10/08/03 Decision on Appeal -- Examiner Reversed
11. 07/28/04 Fourth Non-final Office Action Rejection

This application was filed on November 17, 1998. Appellants' *original* claims still have not been amended. Yet this application has received continued reopening of prosecution, including four non-final rejections. As factually evidenced by the prosecution history, the Office's propensity to continuously prosecute this application is not in conformance with the Office's normal and expected examining procedures, especially with regard to "compact

prosecution.” In light of the assigned Group’s inability to efficiently examine this application, this application should be transferred to an examining Group that is capable of meeting the stated prosecution goals of the Office.

The obfuscation and delay by the examining Group constitutes arbitrary and capricious conduct against Appellants. The Office’s latest non-final new rejection was made (without any formal suspension) nearly 10 months after a Board decision that completely reversed the examiner. This latest non-final new rejection, which was signed by a Supervisor and a Director, must bring closure to examination of this application. Should the Office apply yet another non-final new rejection, such action would constitute further arbitrary and capricious action and evidence of willful or wanton misconduct against Appellants.

The repeated imposition of new grounds of rejection by the Office in an effort to deny Appellants judicial review of the refusal to grant their application constitutes an abuse of agency authority. Such actions violate the Administrative Procedures Act, 5 U.S.C. § 701 *et seq.* Such agency action also violates the fundamental legal principle that an administrative agency may not avoid review of its actions by engaging in repetitive activity which does not remain in place long enough to enable judicial review. *Southern Pacific Terminal Co. v. Interstate Commerce Com.*, 219 U.S. 498, 55 L.Ed. 310, 31 S. Cr. 279 (1911).

Appellants strongly desire to proceed with their appeal to prevent even further unnecessary prosecution delay caused by the Office. Furthermore, as shown in more detail herein, Appellants’ claims are allowable over the (latest) new grounds of rejection. Thus, Appellants respectfully request reinstatement of their appeal.

(v) SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of exemplary forms of the claimed invention:

With respect to independent claim 1

An exemplary form of the invention is directed to an apparatus. The apparatus comprises an automated banking machine (12) (page 11, lines 13-14; page 13, lines 4-5). The exemplary embodiment of the automated banking machine is an automated teller machine (“ATM”).

The automated banking machine (12) includes an output device (e.g., display screen 30) (page 7, line 2; page 13, lines 5-6). The output device can output information, enabling an automated banking machine user to perceive outputs from the output device.

The automated banking machine (12) includes an input device (e.g., keyboard 40 or reader device 38) (page 7, line 3; page 9, lines 4-5; page 13, lines 12-13; and page 29, lines 20-21). The input device can receive inputs, enabling a user of the automated banking machine to provide inputs to the machine.

The automated banking machine (12) includes a transaction function device (36; 42) (page 13, lines 11-18). The transaction function device (36; 42) can selectively carry out a transaction function.

The automated banking machine (12) includes a computer (34). The computer (34) is in operative connection with the output device, the input device, and the transaction function device (page 13, lines 8-12).

The automated banking machine (12) includes software (e.g., 64, 76, 80) executable in the computer (34) (page 14, lines 11-13; page 15, lines 17-18; page 16, lines 9-18). The software

includes a browser (76) (page 15, lines 17-18). The browser (76) can process HTML documents having instructions therein (page 16, lines 9-15; page 53, lines 8-9). The transaction function device (36; 42) can carry out (page 20, lines 7-8) the transaction function responsive to the browser (76) processing at least one document including at least one instruction that can cause the computer (34) to cause operation of the transaction function device (36; 42) (page 33, lines 11-13; page 34, lines 18-21; page 9, lines 19-20). Particularly note Figures 2 and 11.

Thus, in an exemplary form of the invention, an ATM (12) can receive HTML documents containing operation instructions, process the instructions using the ATM browser (76), and then (in response to the instructions) cause the ATM computer (34) to operate an ATM transaction function device to carry out an ATM banking transaction function. The HTML document instructions cause the ATM computer (34) to operate the ATM transaction function device.

An example of operation of an exemplary embodiment encompassed by claim 1 will now be described. The ATM is connected to a network such as the Internet and receives at least one HTML document from a remote server computer connected in the network. The received HTML document includes embedded JAVA[®] script or other instructions that are processed by the ATM browser. The ATM computer includes software comprising a JAVA applet associated with the operation of a currency note dispenser in the ATM. The ATM computer processed instructions operate in the JAVA environment to communicate a message to the JAVA applet associated with the currency note dispenser. Thus, the ATM computer operates in response to instructions included in the received HTML document to control a currency note dispenser to dispense currency notes.

With respect to independent claim 8

Another exemplary form of the invention is directed to the Automated Teller Machine (ATM) (12) of claim 8 (page 11, lines 13-14; page 13, lines 4-5). The ATM (12) includes a computer (34) (page 13, lines 8-12) with a browser (76) (page 15, lines 17-18). The ATM (12) also includes a transaction function device (36; 42) (page 13, lines 11-18) in operative connection with the computer (34). The transaction function device can carry out a transaction function responsive to at least one HTML format document that is received by the browser (76) (page 33, lines 11-13; page 34, lines 18-21; page 9, lines 19-20; page 16, lines 9-15; page 53, lines 8-9; page 60, lines 5-8). Particularly note Figures 2 and 11.

With respect to independent claim 9

Another exemplary form of the invention is directed to the method of claim 9. The method comprises operating a browser (76) in at least one computer (34) in connection with an automated banking machine (12). The method further comprises receiving at least one HTML format document with the browser (76) (page 16, lines 9-15). The at least one HTML format document includes at least one transaction instruction (page 9, lines 17-20; page 53, lines 8-9; page 60, lines 5-8). The method also comprises carrying out (page 20, lines 7-8) at least one transaction function with a transaction function device (36; 42) in the automated banking machine (12) responsive to the at least one HTML format document (page 33, lines 11-13; page 34, lines 18-21; page 9, lines 19-20).

The previous discussions of automated banking machine (12), computer (34), and browser (76) are herein incorporated by reference. Particularly note Figures 2 and 11.

With respect to independent claim 11

Another exemplary form of the invention is directed to the method of claim 11. The method comprises operating a browser (76) in at least one computer (34) in operative connection with an automated banking machine (12). The method further comprises receiving at least one document with the browser (76) (page 16, lines 9-15). The document includes at least one transaction instruction embedded therein (page 9, lines 17-20; page 53, lines 8-9; page 60, lines 5-8). For example, note “embedded” at page 12, line 3; page 16, lines 11 and 13; page 33, line 12; page 39, line 2; and page 45, line 12. The method also comprises carrying out (page 20, lines 7-8) at least one transaction function with a transaction function device (36; 42) in the automated banking machine (12) responsive to the at least one document (page 33, lines 11-13; page 34, lines 18-21; page 9, lines 19-20).

The previous discussions of automated banking machine (12), transaction function device (36; 42), computer (34), and browser (76) are herein incorporated by reference. Particularly note Figures 2 and 11.

With respect to independent claim 12

Another exemplary form of the invention is directed to the Automated Teller Machine (ATM) (12) of claim 12 (page 11, lines 13-14; page 13, lines 4-5). The ATM (12) can operate (36; 42) to conduct (page 20, lines 7-8) at least one financial transaction responsive to at least one mark-up language document (page 33, lines 11-13; page 34, lines 18-21; page 9, lines 19-20). Particularly note Figures 2 and 11.

With respect to independent claim 13

Another exemplary form of the invention is directed to the automated banking machine (12) of claim 13. The automated banking machine (12) comprises a computer (34) and at least one transaction function device (36; 42) in the banking machine (12). The at least one transaction function device (36; 42) is adapted to carry out at least a portion of a banking transaction (page 33, lines 11-13). The computer is adapted to cause at least one banking transaction to be carried out through operation of the at least one transaction function device responsive to at least one mark up language document (page 33, lines 11-13; page 34, lines 18-21; page 9, lines 19-20). Particularly note Figures 2 and 11.

With respect to independent claim 16

Another exemplary form of the invention is directed to the method of claim 16. The method comprises providing an automated banking machine (12) including at least one transaction function device (36; 42). The automated banking machine is in operative connection with at least one computer (34). The method further comprises processing (page 16, lines 9-15; page 53, lines 8-9) at least one mark up language document with the computer (34, 76) (page 15, lines 17-18). The method also comprises carrying out (page 20, lines 7-8) at least a portion of a banking transaction with the transaction function device (36; 42) responsive to processing the at least one mark up language document with the computer (34) (page 33, lines 11-13; page 34, lines 18-21; page 9, lines 19-20). Particularly note Figures 2 and 11.

(vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The questions presented in this appeal are:

- 1). Whether claim 12 is unpatentable pursuant to 35 U.S.C. § 112, first paragraph.
- 2). Whether claim 27 is unpatentable pursuant to 35 U.S.C. § 112, second paragraph.
- 3). Whether claims 1, 3-4, 6-14, 16, 18-20, 22-28, and 30 are unpatentable pursuant to 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0006657 (hereinafter “Wagner Publication”).
- 4). Whether claims 2, 5, 15, 17, and 28 are unpatentable pursuant to 35 U.S.C. § 103(a) over the Wagner Publication.
- 5). Whether claim 27 is unpatentable pursuant to 35 U.S.C. § 103(a) over the Wagner Publication in view of Russell, *et al.* (U.S. Patent 5,905,248) (hereinafter “Russell”).

Additional Comments

It is noted that the Action was signed by both the Supervisor and the Director. Thus, Appellants presume that with the almost 10 month period between the Board decision and the Action’s mailing, careful review of the Action was made by both the Supervisor and the Director.

The Action lacks clarity and contains errors. In spite of the Action’s glaring defects, Appellants desire to proceed with their appeal to prevent further unnecessary prosecution delay (and errors) by the Office. In light of Appellants’ presumptions (presented below) alleviating the defects in the Action, an Examiner’s Answer is respectfully requested in response to this Appeal Brief.

Alleviation of Defects in the Action (so the appeal can proceed without remand)

The Action at page 3, numbered paragraph 5, indicates that claim 27 was rejected under 35 U.S.C. § 102(e) by the Wagner Publication. However, the body of the rejection lacks a discussion regarding claim 27. The 35 U.S.C. § 102(e) rejection of claim 27 based on the Wagner Publication also conflicts with the 35 U.S.C. § 103(a) rejection of claim 27 based on the Wagner Publication (at Action page 10, numbered paragraph 10). The Action also admits (in the 35 U.S.C. § 103(a) rejection of claim 27) that the Wagner Publication does not teach all of the recited features of claim 27. Thus, as best understood, Appellants presume that the rejection heading at page 3, numbered paragraph 5, should (be without claim 27 and) read “Claims 1, 3-4, 6-14, 16, 18-20, 22-26, 28, and 30.” That is, the heading should not have included reference to claim 27. Nevertheless, as shown in more detail later, Appellants have separately presented arguments against the 35 U.S.C. § 102(e) rejection of claim 27.

The Action at page 3 indicates that claims 4 and 14 were rejected pursuant to 35 U.S.C. § 102(e). The body of the rejection pertaining to claim 4 is discussed on page 4 of the Action. However, the Action at page 6, line 1, again refers to claim 4. This second reference to claim 4 appears to be a typographical error as the paragraph containing this language does not correspond to claim 4. Furthermore, by following the chronological order in the body of rejections, it appears that this section (on page 6, first paragraph) should refer to claim 14 instead of the already discussed claim 4. Thus, as best understood, Appellants presume that “claims 4 and 28” in line 1 at Action page 6 should read “claims 14 and 28.” That is, claim 14 is viewed as being only rejected pursuant to 35 U.S.C. § 102(e), and the body of the claim 14 rejection is on page 6, first paragraph, of the Action.

The Action at page 8, numbered paragraph 8 (in the heading), indicates that claim 28 was rejected under 35 U.S.C. § 103(a) by the Wagner Publication. However, the body of the rejection lacks a discussion regarding claim 28. Furthermore, the 35 U.S.C. § 103(a) rejection of claim 28 conflicts with the 35 U.S.C. § 102(e) rejection of claim 28 (on Action pages 3 and 6). Numbered paragraph 8 (in the body) does refer to claim 29. Claim 29 has not been rejected pursuant to 35 U.S.C. § 102(e). Thus, as best understood, Appellants presume that the rejection heading at page 8, numbered paragraph 8, should read “Claims 15 and 29.” That is, claim 28 is viewed as being only rejected pursuant to 35 U.S.C. § 102(e), and claim 29 is viewed as being only rejected pursuant to 35 U.S.C. § 103(a) with Wagner.

The Summary on page 1 of the Action indicates that all of the claims 1-30 stand rejected. However, none of the rejection headings or bodies refer to claim 21. Claim 21 recites “the transaction function device includes a depository.” This language corresponds to language in claim 5. No other claim appears to refer to a “depository.” Thus, in another attempt by Appellants to prevent even further prosecution delay by the Office, Appellants will view the rejection heading at page 8, numbered paragraph 7, as reading “Claims 2, 5, and 21.” That is, claim 21 is viewed as being rejected pursuant to 35 U.S.C. § 103(a) based only on the Wagner Publication. Of course the Office is encouraged to indicate allowance of claim 21.

Thus, the art-based rejections are viewed by Appellants as follows:

Claims 1, 3-4, 6-14, 16, 18-20, 22-26, 28, and 30 have been rejected pursuant to 35 U.S.C. § 102(e) over the Wagner Publication.

Claims 2, 5, 15, 17, 21, and 29 have been rejected pursuant to 35 U.S.C. § 103(a) over the Wagner Publication.

Claim 27 has been rejected pursuant to 35 U.S.C. § 103(a) over the Wagner Publication in view of Russell.

Appellants view the Action in light of their presumptions. Appellants' presumptions have been made to advance prosecution. Appellants hope that their presumptions will alleviate the need to remand the application to the Examiner with regard to the stated rejections.

Appellants reserve all rights to amend their arguments, including the filing of another Supplemental Appeal Brief, if their many presumptions, necessitated by the unclear Action, are incorrect. As shown in more detail later, the Office's lack of clarity in presenting the rejections is merely reflective of the impropriety of all the rejections on appeal.

Also, as later discussed in detail, the Wagner Publication has a filing date more than four and one-half years after the filing date of the present application. The Wagner Publication has a filing date that is more than six and one-half years after the filing date of Appellants' provisional application (which fully supports the claims on appeal) and more than seven years after Appellants reduced the claimed invention to practice as established through the Declaration and documentary evidence that was accepted by the Board of Appeals in the prior decision (Appeal No. 2003-1651) reversing the examiner on all counts. As the Wagner Publication is clearly not prior art to the claimed invention, Appellants have also addressed any assertions that could be made with regard to the only prior application having a filing date prior to the effective filing date of the present application of which the Wagner Publication claims priority, namely U.S. Patent No. 5,742,845 (hereafter "Wagner" or "the Wagner patent").

(vii)

ARGUMENT

Rejection under 35 U.S.C. § 112, First Paragraph

Claim 12 has been rejected under 35 U.S.C. § 112, first paragraph, as being a “single means claim.” The Appellants respectfully disagree. Appellants’ application meets the requirements of 35 U.S.C. § 112, first paragraph.

Claim 12 recites:

An Automated Teller Machine (ATM) that operates to conduct at least one financial transaction responsive to at least one mark-up language document.

Claim 12 is not drafted using a means-plus-function format. Claim 12 does not use “means” or “means for.” Claim 12 does not invoke 35 U.S.C. § 112, sixth paragraph. Thus, claim 12 cannot be a “single means claim”, as the Office alleges.

Furthermore, there is nothing wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. Appellants’ functional limitation is used in association with an element to define a particular capability or purpose that is served by the recited element. The recited functional limitation serves to precisely define present structural attributes of the claimed invention. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976). MPEP § 2173.05(g).

The Action's comment that "there are no distinct functions that make the device of claim 12 an ATM" is without merit. Nor is the comment a 35 U.S.C. § 112, first paragraph, issue. The Action's comment is analogous to saying that "there are no distinct functions that make an Appeal Brief an Appeal Brief." Appellants' are not required to recite apparatus structure at the atomic level. The Office's own patent classification system recognizes an "ATM" (e.g., class/subclass 705/43). It is respectfully submitted that claim 12 is not a means claim and the rejection should be reversed.

Rejection under 35 U.S.C. § 112, Second Paragraph

Claim 27 was rejected under 35 U.S.C. § 112, second paragraph, on the grounds of being indefinite. This rejection is respectfully traversed.

Claim 27 depends from claim 16. Claim 16 at step (c) recites “carrying out at least a portion of a banking transaction with the transaction function device responsive to processing the at least one mark up language document with the computer in step (b).” Claim 27 recites “wherein the computer is operative to cause the carrying out of the portion of the banking transaction responsive to at least one software applet.” Appellants respectfully submit that claim 27 is not indefinite. Claim 27 also further limits claim 16. Claim 27 meets the requirements of 35 U.S.C. § 112, second paragraph. Appellants respectfully submit that the 35 U.S.C. § 112, second paragraph, rejection is not appropriate and should be withdrawn.

Nevertheless, Appellants respectfully submit that this issue has previously been addressed and resolved. In the previous Board decision it was deemed that the 35 U.S.C. § 112 rejection, second paragraph, rejection was no longer an issue. In response to the Board decision, the Appellants and the examiner agreed to mutually acceptable language (as set forth in Appellants’ proposed amendment submitted October 22, 2003). Note the Interview Summary (dated October 22, 2003; labeled as paper no. 26; and attached to the Action) indication that the proposed amendment was authorized. Following Appellants’ submitted proposed amendment, the PTO’s PAIR system listed a Notice of Allowability entry dated November 3, 2003. As a courtesy to the Office, respective copies of both Appellants’ proposed amendment dated October 22, 2003 and a printout (dated July 13, 2004) showing the PAIR Notice of Allowability entry have been provided in a paper (labeled “Courtesy Copies”) submitted separately from this Second

Supplemental Appeal Brief. (The entry has since been removed from PAIR, the legality thereof being a different issue). This PAIR entry provides evidence that the language set forth in Appellants' proposed amendment was acceptable to the Office.

It appears that because the application was subsequently not allowed, the examiner's amendment was somehow treated as not being officially entered. (Thus, claim 27 in the Claims Appendix does not include the changes submitted October 22, 2003.) However, the Office (at Action page 3) again invites Appellants to "Please consider revising claim 27." Appellants again accept the offer to have claim 27 amended. Appellants still agree to have claim 27 amended by examiner's amendment in accordance with the mutually agreed to language set forth in Appellants' proposed amendment submitted October 22, 2003. That is, even though it is respectfully submitted that the original claim language is clear and definite, Appellants are again willing to have claim 27 revised to include mutually agreeable language. Therefore, since both the Office and Appellants agree to again resolve the matter by amendment, the 35 U.S.C. § 112, second paragraph, rejection is no longer an issue.

The 35 U.S.C. § 102 (e) Rejections

The Applicable Legal Standards

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is “necessarily present” in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

Wagner (U.S. Patent No. 5,742,845)

The disclosure of Wagner (U.S. Patent No. 5,742,845) is silent as to the exact details concerning complete and enabling operation of the system. Therefore, the description of any portion of Wagner herein or any comments directed thereto shall not be construed as an agreement or an admission by Appellants that Wagner's system is capable of achieving any of Appellants recited features.

Wagner states that his invention is a system in which non-standard devices (ones that do not conventionally communicate directly with a network) do directly communicate both in an open network and in a conventional analog public telephone network to carry out operations. However, Wagner's description contains inconsistencies and appears to be missing parts of the system description. In light of Wagner's confusing disclosure, Appellants respectfully submit that remarks made by Wagner during prosecution of the application (08/493,772) should first be reviewed to help interpret the disclosure. The following remarks were taken from the prosecution history of Wagner (U.S. Patent No. 5,742,845). These remarks created prosecution history estoppel. As a courtesy to the Office, a copy of the prosecution history of Wagner showing said remarks has been provided in a paper (labeled "Courtesy Copies") submitted separate from this Second Supplemental Appeal Brief. Any underlining has been added by Appellants.

In the amendment dated May 12, 1997

"Open network protocols exist which support communications between a server and standard open network devices such as personal computers . . . However, these open network protocols do not support communications between non-standard I/O devices . . .

The extended open network protocol of the present invention permits these types of devices to be coupled to an open network and communicate with a server as if the non-standard device were a PC on the network” (paragraph bridging pages 6 and 7).

“communications . . . over the open network are in a standardized and known open network protocol. There is no teaching or suggestion of extending the open network protocol, such as X-Windows protocol, to accommodate non-standard I/O devices on the open network . . . the reference completely fails to disclose the extension of any open network protocol to communicate with non-standard I/O devices over an open network. The reference fails to contain such teachings because (1) no non-standard I/O devices are disclosed as being coupled to the open network disclosed in the reference, (2) the open network protocol disclosed in the reference is a standard interface, and (3) communications with devices which normally operate over a proprietary network are performed using a shared memory or graphics card rather than an extended open network protocol” (page 8, first paragraph).

“Nor is there any disclosure of an open network protocol, much less an extension of an open network protocol. Instead, this reference teaches known methods for interfacing such devices to a processor, namely, the use of a non-network interface to support point-to-point communication. Thus, there is no teaching or motivation to couple non-standard devices to an open network system.

Furthermore, there is no teaching or suggestion of an extended open network protocol to communicate with such devices” (page 9, first paragraph).

“Even though a server is shown communicating with client programs using an open network protocol . . . there is no teaching or suggestion that the open network protocol is extended to support communication with non-standard I/O devices . . . the open network protocol disclosed in the reference is an open interface standard which is readily available and well known to those skilled in the art . . . There is no teaching or suggestion that this open network protocol is extended in any way to support communication with non-standard I/O devices” (page 10, first full paragraph).

“The open network protocol of Phillips is not modified or extended to include the ability to support communication by using tags, action attributes, or method attributes. None of the cited reference teach the use of these elements to support communication with non-standard I/O devices over an open network” (page 11).

In the Examiner’s amendment (Office Action dated 8/20/97)

As specifically stated on page 6 of the Office Action, the Examiner required that the title be changed to be descriptive of the invention *claimed* in the manner “pursuant to MPEP § 606.01.” The title was changed to read “System for extending present open network communication protocols to communicate with non-standard I/O devices *directly* coupled to an open network.” That is, the title was specifically changed by the Examiner to reflect that the claimed invention

extended *present* open network protocols to be able to communicate with *non-standard* I/O devices that were directly on an open network.

The disclosure as set forth in Wagner (US 5,742,845) will now be discussed (as best understood). Wagner desires a system that permits consumers remote from a merchant to order goods and present payment in a secured manner so the merchant's risk and processing costs, as well as a cardholder's exposure to fraud, are reduced (col. 5, lines 19-22). The system connects "non-standard I/O devices" to an open network, such as the Internet, to achieve secured payment communication.

Wagner explains that a *merchant-initiated* transaction includes safeguards, that are not available for a consumer-initiated transaction (col. 4, line 55 to col. 5, line 22). Wagner's system is directed to enabling a more secure *consumer-initiated* transaction (col. 5, lines 12-13 and 19-22; col. 6, lines 16-20; col. 7, lines 10-11). Wagner's system enables a consumer to initiate a transaction, order from a merchant, and use a more secure link supported by a non-standard I/O device (such as a card reader or PIN pad) to reduce the risk of fraud for the transaction.

Wagner's system requires that the non-standard I/O device have the ability to communicate on an open network (col. 5, lines 48-51).

Wagner specifically defines and distinguishes "non-standard I/O devices" from standard I/O devices. Wagner, as best understood, implies *standard* I/O devices as those I/O devices already supported by Internet protocols such as computers (PCs 30). Wagner indicates *non-standard* I/O devices are those I/O devices that do not directly communicate on a network but rather use communication interfaces such as RS-232C to communicate with a computer (col. 3, lines 62-64; col. 4, lines 4-7; col. 10, lines 5-6) and that have been unsupported for

communication directly on the Internet (Abstract lines 5-6; col. 4, lines 4-12; col. 5, lines 43-47; col. 6, lines 16-20; col. 9, lines 60-63). Wagner also refers to *standard* PCs (col. 3, line 57). Thus, Wagner admits that a non-standard I/O device is not a computer (col. 4, lines 4-12; col. 5, lines 43-47; col. 9, lines 60-63).

Wagner in the Background section indicates that (in 1995) a limitation of the Internet was that direct network communication was only supported for computers acting as servers or clients (col. 3, lines 54-58). That is, all of the (1995) protocols and formats were constructed for standard input/output (I/O) operations for computers, such as *standard* PCs (30). Text information was directed to a standard monitor screen, user input was expected from a standard keyboard, and files were transferred to standard peripherals such as a hard disk (col. 3, lines 58-62). Especially absent was the ability in Internet protocols for communication directly with “non-standard I/O devices.” As a result, communication over the Internet was performed with standard PCs through standard network communication methods and interfaces (col. 3, lines 64-67). Non-standard I/O devices communicated with a PC, and the PC communicated with other computers in the network.

Per Wagner’s explanation, servers used protocols that communicated with PCs, and the PCs in turn communication with conventional QWERTY keyboards and standard monitors (col. 4, lines 9-16). Consequently, PC users were limited to entering account numbers and the like through the PC’s standard keyboard. To initiate a remote transaction, one only needed to have someone’s credit card account number (without requiring physical possession of the actual credit card).

Wagner desired the ability to physically input a credit card number to achieve more secure home-based transactions initiated by consumers. If the credit card number had to be input through a magnetic card reader, then unauthorized access to a customer's account would be less likely (col. 4, lines 16-19). This was because physical possession of the credit card would be required to initiate the transaction.

Wagner indicates that another limitation of home-based Internet transactions was lack of encryption (col. 4, lines 21-23). When a PC's standard keyboard was used to input an account number or PIN, no encryption was performed and, as a result, an unencrypted copy of the PIN was stored in the memory of the PC (col. 4, lines 28-32). Storage of unencrypted PINs was undesirable and contrary to banking regulations.

Wagner desired the ability to use a PIN pad to achieve more secure home-based Internet transactions. A PIN pad could automatically encrypt a consumer's entered personal identification number (PIN) before the PIN was transmitted or stored. With the use of a PIN pad then a lapse in PIN security would be less likely to occur (col. 4, lines 32-34).

In order to achieve the desired system, Wagner concluded that a new open network protocol had to be created that would allow direct communication in the network of the non-standard I/O devices (e.g., card reader and PIN pad). With the new protocol, a transaction processing center could communicate with each non-standard I/O device connected *directly* to the open network (col. 9, lines 61-65). As previously mentioned, Wagner teaches that non-standard I/O devices are *not* computers (PCs) (e.g., Abstract lines 5-6). Wagner's new protocol extended his (1995) open network communication protocols to permit direct communication of each of these non-standard I/O devices directly in the open network (e.g., col.

6, lines 8-12, 45, and 49-50; col. 9, lines 61-65). Alternatively (but clearly not consistent with Wagner's explanation that a non-standard I/O device communicates directly in a network), Wagner states that a personal computer (PC) can be used as a communication link to couple the non-standard I/O device to the open network (col. 10, lines 33-36). Apparently a PC (although not needed) could be used to merely provide a communication connection for a non-standard I/O device that is capable of communicating by direct connection in the network. Why anyone would want to do this is one of the inconsistent teachings of Wagner. Apparently the PC would be part of a circuitous communication path that helps pass information therethrough to and from the network and the non-standard I/O device that has the capability of being connected directly to the open network (e.g., col. 5, lines 48-58; Wagner's claim 17).

Wagner's system requires corresponding changes to both standard communication protocols and message formats such as HTTP and HTML. Specifically, Wagner's HTTP protocol needed to be expanded to enable direct network communication with non-standard I/O devices (col. 6, lines 8-16 and 28-34). Wagner distinguishes his extended HTTP protocol from standard HTTP protocol (col. 10, line 52; col. 11, lines 28, 34-35; and 53). A server can access a Wagner non-standard I/O device as a result of its URL. A feature of Wagner's system is new commands (e.g., PAYMENT command) implemented in the special extended HTTP Internet protocol (col. 6, lines 54-58; col. 11, lines 58-61). The Wagner extended HTTP protocol can include "a command which instructs a non-standard I/O device" (regarding disconnection from the open network) (col. 6, lines 12-13).

Likewise, Wagner's system also correspondingly changes message formats such as HTML to support direct communication between a server and his non-standard I/O devices (col.

11, lines 21-23 and 51-52; col. 14, lines 7-15). Wagner distinguishes his special extended form of HTML from standard HTML (col. 11, lines 17-24 and 36-38; col. 13, lines 57-58; col. 15, lines 23-25 and 56-63).

In Wagner's system a non-standard I/O device requires its own processor of a Z80A type or better, at least 32K bytes of RAM, and at least 32K bytes of ROM (col. 13, lines 7-9). A client program executes in the processor of the non-standard I/O device (col. 12, lines 25-26 and 34-39; col.13, line 14). The client program interprets the Wagner special HTTP protocol which communicates Wagner's special form message format for communicating data directly between the non-standard I/O device and a network server (col. 11, lines 5-8).

As previously discussed, Wagner's goal is to permit consumers remote from a merchant to initiate transactions, order goods, and present payment in a secured manner (col. 6, lines 23-27, 34-39, 41-46, and 49-52). Wagner's system permits a consumer at home to collect product information over the Internet while using non-confidential communication (col. 7, lines 16-18), and then use confidential communication for the payment transaction (col. 6, lines 8-16; col. 7, lines 15-25; col. 11, lines 58-67; col. 18, lines 26-36 and 56-64). Wagner's system permits product information to be collected quickly and efficiently. Later, when the consumer desires to purchase the product, the extended Internet protocol (using PAYMENT) enables use of a separate non-Internet, telephone based secure communications link (e.g., VISA protocol) for transmitting confidential payment (credit card account) information. The PAYMENT command implemented in Wagner's special Internet protocol (col. 6, lines 54-58; col. 11, lines 58-61) causes the connection of the secure (non-Internet) communications link between the non-standard I/O device and a transaction processing center that is accessed via a telephone line.

Figure 13A of Wagner shows an example of communication paths available for a non-standard I/O device (420) implementing Wagner's invention. The example is described at col. 18, lines 7-64. (and apparently col. 6, line 28 to col. 7, line 25). Three party (consumer, merchant, and transaction processing center) communication can be used to carry out a transaction. The non-standard I/O device (420) in Figure 13A appears to be a magnetic stripe reader/PIN pad (col. 18, line 30). The non-standard I/O device (420) communicates through the World Wide Web (426) with an Internet Web server (12) (likewise, the server in Figure 1 is also labeled "12"). The non-standard I/O device (420) and server (12) communicate over the Internet using Wagner's special extended protocol (col. 18, lines 11-12).

When a payment is to be made by the consumer, the Wagner system enables a command from the web server (12) to cause a telephone connection to be made so as to provide a more secure physical connection between the non-standard I/O device (420) and a transaction processing center to provide communication that is used to make payment (col. 18, lines 15-17). To open the more secure telephone connection, Wagner's special PAYMENT command is used. The PAYMENT command causes the non-standard I/O device (420) to suspend (col. 18, line 43) its Internet communication path (426) and activate an application (e.g., a bank card authorization application) that uses a standard analog signal Public Switched Telephone Network (PSTN) communication path (424). The non-standard I/O device (420) which is now disconnected from the Internet, can then pass the consumer's sensitive credit card account information to a remote transaction processing center (422) via the more secure (PSTN) communication path (424). The processing center (422) can conventionally authorize or deny the transaction. The processing center (422) can also submit remittance data to a merchant via the Internet (col. 18, lines 53-54)

so that the merchant knows the user has paid the required amount and the consumer receives their goods. Thus, the non-standard I/O device (420) can directly communicate on the Internet with a plurality of merchant Web servers (12) to shop for a best price, and then upon receiving a non-standard PAYMENT instruction using Wagner's special extended protocol, utilize a more secure standard telephone - communication connection to pay for the selected product (col. 18, lines 56-64).

In review, Wagner admits that the (1995) Internet suffered from a number of limitations (col. 3, lines 40-44) which precluded its effective use as a complete transaction system. For example, Internet communication lacked the security (col. 3, lines 45-53) of standard telephone communication (which could use non-standard I/O devices) for transaction payment. Wagner desired a complete transaction system that could use both the information gathering advantage of the Internet (col.2, line 64 to col. 3, line 39) while maintaining the secure payment advantage of standard telephone lines (col.2, lines 4-25).

Wagner needed a way to link the Internet and PSTN for standard phone line connections to credit card payment processing centers. Wagner enabled non-standard I/O devices (which could already communicate over phone lines) to also directly connect to the Internet for communication. Wagner created a new special Internet protocol that would provide *direct* Internet communication with non-standard I/O devices (e.g., col. 6, lines 8-12, 45, and 49-50; col. 9, lines 61-65). The non-standard I/O device had its own internal processor running both a client program and a conventional financial transaction application (col. 18, lines 21-25). The client program operated in response to the special Wagner Internet protocol and, in response to a special PAYMENT instruction, disconnected from the Internet and activated the conventional

financial transaction application that carried out a payment transaction via phone line (col. 11, lines 58-65; col. 18, lines 27-33 and 43-48). That is, the new Internet protocol controlled the non-standard I/O device directly so that it switched from Internet communication to phone line communication for secure transaction payment.

Thus, Wagner undertook to combine the advantages of the Internet with a more secure telephone communication link while using data security enhancing devices (e.g., PIN pad) (col. 7, lines 22-25). The ability of a non-standard I/O device to directly communicate with an open network server (via the unique extended Internet protocol) enabled Wagner's goal of a more secure consumer-initiated transaction to be achieved.

The Wagner Publication Does Not Constitute Prior Art

As discussed in more detail herein, the Wagner Publication does not constitute prior art against Appellants' invention. The Wagner Publication is not entitled to the June 22, 1995 filing date of the parent Wagner patent 5,742,845 for the features relied upon in the rejections. For reasons of brevity, the Wagner patent 5,742,845 will hereafter be referred to as the "Wagner patent" or simply "Wagner".

Appellants respectfully submit that the Wagner Publication is limited to the July 7, 2003 filing date for the relied upon features. At best, the Wagner Publication is a continuation-in-part of the Wagner patent. However, the present invention is entitled to (and claims benefit of) the earlier November 27, 1996 filing date of provisional application 60/031,956. As the Wagner Publication does not constitute prior art against Appellants' invention, the rejections relying thereon (which includes all the art rejections) are not valid.

Reasons why the Wagner Publication is not entitled to the June 22, 1995 filing date of Wagner

The parent Wagner patent (US 5,742,845) does not provide support for the features relied upon in the Wagner Publication. That is, the features relied upon in the Wagner Publication for the rejections are not found in the Wagner patent.

The Board should suspiciously ask the following question: *Why wasn't the earlier Wagner patent applied in place of the Wagner Publication, especially if the Wagner patent (as alleged by the Office) supports the features relied upon in the Wagner Publication?* Appellants respectfully submit that the Office did not apply the Wagner patent because it does not teach the features relied upon in the Wagner Publication. The absence in the Action of a 35 U.S.C. §

102(e) rejection based on the parent Wagner patent is *prima facie* evidence of the lack of support therein.

The Action relies on the Wagner Publication at claims 1-8, the Abstract, and paragraphs 0003 and 0020. Appellants will show in more detail hereafter that the Wagner Publication's Abstract and claims 1-8 contain new matter not found in the Wagner patent. This new matter is not entitled to the earlier filing date of the Wagner patent.

The Wagner Publication does have support in the Wagner patent for paragraphs 0003 and 0020. However, the subject matter of these paragraphs is not pertinent to ATMs or the recited invention.

The Abstract in the Wagner Publication does not have support in US patent 5,742,845

The Wagner Publication's Abstract reads

“An automated teller machine (ATM) implements financial transactions over the Internet. The ATM includes a computer and at least one non-standard I/O device coupled to the computer. The computer of the ATM interprets extended open network protocol statements to control the non-standard I/O device for purposes of implementing a financial transaction.”

The Wagner patent does not provide support for the Wagner Publication's Abstract language. Wagner (US 5,742,845) does not provide support for an ATM that “implements financial transactions over the Internet.” Nowhere does Wagner explicitly or inherently teach that an ATM communicates via the Internet. Where does Wagner discuss operating an ATM over the Internet? ATMs are mentioned only in the prior art Background section of Wagner.

Wagner mentions “ATM” at col. 1, lines 26, 29, 47, 60, 65; col. 2, line 1; and col. 4, line 24. An ATM is *not* a part of Wagner’s invention.

Nor does Wagner provide support for the Abstract language “The ATM includes a computer and at least one non-standard I/O device coupled to the computer.” Where does Wagner discuss an ATM computer? Wagner mentions a PC. Wagner does not teach that a personal computer (PC) constitutes a (public) ATM computer. Where does Wagner teach that in 1995 a personal computer could operate an ATM?

Where does Wagner teach a non-standard I/O device coupled to an ATM computer? Wagner does not provide support for a non-standard I/O device coupled to an ATM computer. Where does Wagner discuss that devices in an ATM are non-standard I/O devices? In Wagner, non-standard I/O devices are specifically defined as devices which can be coupled to PCs through non-standard I/O ports not normally used for networks, such as COMM1 and COMM2 ports (col. 9, line 65 to col. 10, line 6). These non-standard I/O devices are coupled to a PC through an interface such as an RS-232C interface. Even if an ATM had a PIN pad, this does not teach that the PIN pad is connected to an RS-232C port, especially an RS-232C port of a PC. Wagner distinguishes an ATM from a PC. Wagner does not teach that an ATM includes a PC.

Nor does Wagner provide support for the Abstract language “The computer of the ATM *interprets* extended open network protocol statements.” As previously discussed, Wagner’s PC is not an ATM computer. Even if it were somehow possible (which it is not) for Wagner’s PC to constitute an ATM computer, Wagner teaches that the PC (if even used) merely provides a network connection for a non-standard I/O device (col. 10, lines 33-36). The non-standard I/O device of the Wagner invention is one that by definition can be directly connected to the Internet.

Thus when such a device is connected to a PC the PC is merely part of a circuitous communication path which passes information therethrough to and from the non-standard I/O device. That is, in Wagner the information passes *through* the PC. Note the term “through” in Wagner’s claim 17 and col. 5, lines 48-58 (particularly line 52). In Wagner a PC does not *interpret* or process extended open network protocol statements. Rather, by definition it must pass network messages through in the same form they are received from the Internet. Nor does Wagner provide support for an *ATM computer* that *interprets* extended open network protocol statements.

Nor does Wagner provide support for an ATM computer interpreting extended open network protocol statements “to *control* the non-standard I/O device” for purposes of implementing a financial transaction. Nowhere does Wagner explicitly or inherently teach that an ATM computer interprets extended open network protocol statements, especially to *control* a non-standard I/O device (for purposes of implementing a financial transaction).

In Wagner a non-standard I/O device communicates in the modified extended protocol and may be connected directly to the open network. The non-standard I/O device can apparently receive and process the extended protocol. Wagner teaches that the protocol is expanded to enable server communication with non-standard I/O devices (col. 6, lines 8-16 and 28-34). The extended protocol includes a command which controls the non-standard I/O device (col. 6, lines 8-13). As previously discussed this command causes the non-standard I/O device to disconnect from the Internet and connect to a transaction processing system through a phone line.

Wagner provides no teaching whatsoever of his extended protocol (which directly instructs a non-standard I/O device) first instructing an ATM computer, and then having that

computer control the non-standard I/O device. If Wagner's PC (being an alleged ATM computer) interpreted or processed the extended protocol (which it does not) to cause the PC to control the non-standard I/O device (which it does not), then why would Wagner's non-standard I/O device need to communicate in the extended protocol? That is, if in Wagner a computer-interpreted extended protocol caused the computer to act to control a non-standard I/O device (which it does not), then the express purpose of Wagner's invention (not having I/O device inputs such as PINs available in the computer memory of a PC) would be nullified. Furthermore, as previously discussed, Wagner's PC is not an ATM computer. Wagner does not provide support for an ATM computer (or any computer) interpreting *extended* open network protocol statements to have that computer then *control* a non-standard I/O device.

Claim 1 of the Wagner Publication's does not have support in U.S. Patent No. 5,742,845

The Wagner Publication's claim 1 reads

"An automated teller machine (ATM) for implementing financial transactions with a server over an open network comprising: a computer having memory and a processor, the computer being coupled to an open network for communication with a server; at least one non-standard input/output (I/O) device coupled to the computer for performing at least a portion of a financial transaction; and a computer program the memory of the computer and executed by the processor for interpreting extended open network protocol statements received over the open network to control the at least one non-standard I/O device to which the computer is coupled."

The features previously discussed as lacking support in Wagner for the Wagner Publication's Abstract, likewise lack support in the Wagner Publication's claim 1. Wagner does not provide support for an ATM "implementing financial transactions with a server over an open network." Additionally, Wagner does not provide support for an ATM "computer being coupled to an open network for communication with a server." Where does Wagner teach an *ATM computer* in communication with a server via an open network? Nor does Wagner provide support for an ATM computer program "interpreting extended open network protocol statements." Where does Wagner teach interpreting extended open network protocol statements with an *ATM* computer program? Nor does Wagner provide support for an ATM computer program interpreting extended open network protocol statements "to control" a non-standard I/O device. Where does Wagner teach a computer program *in an ATM* that can interpret extended open network protocol statements to *control* a non-standard I/O device? Furthermore, where does Wagner teach an ATM interpreting extended open network protocol statements to control a non-standard I/O device that is *coupled* to the ATM computer?

Wagner provides no teaching whatsoever of an ATM on an open network. Wagner, in the Background section, mentions an ATM as an example of a known transaction terminal (col. 1, lines 25-26, and 34). It appears that the term "computers" at Wagner's col. 1, line 25 should read "terminals". However, Wagner specifically teaches that ATMs are coupled to a central processing system through *dedicated* communication lines for reasons of security (col. 1, lines 60-62). Nowhere does Wagner refute this clear admission. In payment examples, Wagner likewise relies on use of a dedicated data line or PSTN (telephone) network for security (e.g., col. 7, lines 1-6).

Additionally, in Wagner (as best understood) it is the non-standard I/O devices that can directly receive and interpret the extended protocol, not a computer (which Wagner admits is not a non-standard I/O device) (col. 4, lines 4-12; col. 5, lines 43-47; col. 9, lines 60-63), and especially not an ATM computer.

Claims 2-9 depend from claim 1 and likewise lack support in Wagner.

The Wagner Publication's claim 2 does not have support in U.S. Patent No. 5,742,845

Wagner also does not provide support for an ATM comprising a magnetic card reader. Where does Wagner specifically teach an ATM having a magnetic card reader?

Appellants also respectfully disagree that an ATM magnetic card reader is inherent in Wagner. To establish inherency the Office must prove through citation to prior art that the missing component is "necessarily present" in Wagner. The Office has not provided evidence (if somehow possible) that *every* ATM (including Wagner's) has a magnetic card reader. Thus, the Office has not proved through citation to prior art that the alleged feature is "necessarily present" in Wagner. Inherency may not be established based on probabilities or possibilities (which apparently is the present situation). It is plainly improper to allege inherency based merely on the (speculative) possibility that a particular prior art disclosure could or might be used or operated in a manner not specifically disclosed. *In re Robertson, supra*.

The Wagner Publication's claim 3 does not have support in U.S. Patent No. 5,742,845

Wagner also does not provide support for an ATM comprising a smart card reader. Where does Wagner specifically teach an ATM having a smart card reader? The Office has not provided evidence (if somehow possible) that *every* ATM has a smart card reader. Nor has the Office proved through citation to prior art that the alleged feature is "necessarily present" in

Wagner. That is, the Office has not provided evidence that an ATM smart card reader is inherent in Wagner. *In re Robertson, supra.*

The Wagner Publication's claim 4 does not have support in U.S. Patent No. 5,742,845

Wagner also does not provide support for an ATM comprising a ten keypad. Where does Wagner specifically teach an ATM having a ten keypad? The Office has not provided evidence (if somehow possible) that *every* ATM has a ten keypad. Nor has the Office proved through citation to prior art that the alleged feature is “necessarily present” in Wagner. That is, the Office has not provided evidence that an ATM ten keypad is inherent in Wagner. *In re Robertson, supra.*

The Wagner Publication's claim 5 does not have support in U.S. Patent No. 5,742,845

Wagner also does not provide support for an ATM comprising a printer. Where does Wagner specifically teach an ATM having a printer? The Office has not provided evidence (if somehow possible) that *every* ATM has a printer. Nor has the Office proved through citation to prior art that the alleged feature is “necessarily present” in Wagner. That is, the Office has not provided evidence that an ATM printer is inherent in Wagner. *In re Robertson, supra.*

The Wagner Publication's claim 6 does not have support in U.S. Patent No. 5,742,845

As previously discussed, Wagner does not provide support for the claim 1 features of an ATM implementing financial transactions through communication with a server over an open network, nor an ATM computer. It follows that Wagner also does not provide support for an open network ATM comprising a PIN pad. Nor has the Office provided the required evidence showing that the alleged feature is “necessarily present” in Wagner. *In re Robertson, supra.*

The Wagner Publication's claim 7 does not have support in U.S. Patent No. 5,742,845

As previously discussed, Wagner does not provide support for the Wagner Publication's claim 1 features of an ATM implementing financial transactions with a server over an open network, nor an ATM computer, nor an ATM computer interpreting extended open network protocol statements to control a non-standard I/O device. Additionally, in Wagner (as best understood) it is the non-standard I/O devices that can directly receive and interpret the extended protocol, not a computer (which Wagner admits is not a non-standard I/O device at col. 4, lines 4-12; col. 5, lines 43-47; and col. 9, lines 60-63), and especially not an ATM computer. It follows that Wagner also does not provide support for an *ATM computer* interpreting extended HTML statements to *control* a non-standard I/O device. Nor has the Office provided the required evidence showing that the alleged feature is "necessarily present" in Wagner. *In re Robertson, supra.*

The Wagner Publication's claim 8 does not have support in U.S. Patent No. 5,742,845

As previously discussed, Wagner does not provide support for the claim 1 features of an ATM implementing financial transactions with a server over an open network, nor an ATM computer, nor an ATM computer interpreting extended open network protocol statements to control a non-standard I/O device. Additionally, in Wagner (as best understood) it is the non-standard I/O devices that directly receive and interpret the extended protocol, not a computer (which Wagner admits is not a non-standard I/O device) (col. 4, lines 4-12; col. 5, lines 43-47; col. 9, lines 60-63), and especially not an ATM computer. It follows that Wagner also does not provide support for an *ATM computer* interpreting extended open network protocol statements

stored in an HTML document, especially to *control* a non-standard I/O device. Nor has the Office provided the required evidence showing that the alleged feature is “necessarily present” in Wagner. *In re Robertson, supra*.

The Wagner Publication’s claim 9 does not have support in U.S. Patent No. 5,742,845

Wagner provides no teaching whatsoever of an ATM on the Internet. Nor does Wagner provide basis for an ATM computer receiving extended open network protocol statements over the Internet.

Wagner provides an ATM as an example of a known transaction terminal (col. 1, lines 25-26, and 34). However, Wagner specifically teaches that an ATM is coupled to a central processing system through a dedicated communication line (col. 1, lines 60-62).

The Wagner Publication’s claims 10-13 do not have support in U.S. Patent No. 5,742,845

Wagner does not provide support for a transaction server for implementing financial transactions with an automated teller machine (ATM) over an open network. As previously discussed, Wagner provides no teaching whatsoever of an ATM on an open network

The Wagner Publication’s claims 14-20 do not have support in U.S. Patent No. 5,742,845

For reasons previously discussed, Wagner does not provide support for an ATM on an open network. Wagner provides no teaching whatsoever of an ATM on an open network. Nor does Wagner teach an ATM receiving extended open network language statements over an open network. As previously discussed, Wagner also does not provide basis for the other claim features, such as a smart card reader, magnetic stripe reader, and PIN pad.

The Wagner Publication's paragraph 0003

The Wagner Publication's paragraph 0003 finds support in Wagner. The Wagner Publication in paragraph 0003 states that "Transaction *computers* may include special purpose devices such as automatic teller machines (ATMs)." It appears that the term "computers" in paragraph 0003 (Wagner's col. 1, line 25) should read "terminals".

Paragraph 0003 merely indicates an ATM as an example of a known transaction terminal. This paragraph does not teach that an ATM communicates via the Internet. Contrarily, Wagner specifically teaches that an ATM is coupled to a central processing system through a *dedicated* communication line for reasons of security (col. 1, lines 60-62). Payment examples in Wagner likewise rely on a dedicated data line or PSTN (telephone) network (e.g., col. 7, lines 1-6).

The Wagner Publication's paragraph 0020

The Wagner Publication's paragraph 0020 finds support in Wagner (at col. 6, lines 1-27). However, the paragraph does not even mention an ATM. Again, Wagner provides no teaching whatsoever of an ATM on the Internet.

Another example of new matter

Another example of new matter in the Wagner Publication can be found at paragraph 0081 of the Wagner Publication. The preferred file denotation was changed from *<html.sub -- file>* in the Wagner Patent (in the paragraph at col. 17, lines 27-47) to *<html_file>* in the Wagner Publication.

Additional reasons why the Wagner Publication is not entitled to the filing date of the Wagner patent

The Wagner Patent (U.S. Patent No. 5,742,845) is non-enabling

The Wagner Publication is not entitled to the June 22, 1995 filing date of the Wagner Patent because the Wagner Patent (Wagner U.S. Patent No. 5,742,845) is non-enabling. Wagner's disclosure does not meet the requirements of 35 U.S.C. § 112. Thus, Wagner was not entitled to the June 22, 1995 filing date. It follows that the Wagner Publication is not entitled to June 22, 1995 as the effective filing date.

Wagner's use of the term "non-standard I/O device" is vague and indefinite, and renders the disclosure non-enabling. Wagner provides examples of non-standard I/O devices, such as smart card reader (32), PIN pad (34), magnetic card swipe reader (36), and printer (38). To anyone having skill in the computer arts "I/O" means "input/output." However, none of these devices is an *input/output* device. A smart card reader, PIN pad, and magnetic card swipe reader are input-only devices. A printer is an output-only device. Thus, Wagner's use of "I/O device" is not in compliance with known accepted standards. Nor did Wagner specifically redefine the accepted meaning of an "I/O device." It follows that one having ordinary skill in the art would not be able to ascertain the scope of Wagner's disclosed invention. Wagner's disclosure is non-enabling.

Again, the term "*non-standard* I/O device" is vague and indefinite, and not specifically defined to a sufficient degree to overcome the lack of any accepted meaning. Nor is the term one that has an accepted meaning that is well known in the art. The scope of the term appears to

improperly cover every conceivable structure that is not a “standard I/O device.” Such examples include paper and a pencil. The undue breath of the term renders the disclosure non enabling. One having ordinary skill in the art would be unable to carry out Wagner’s disclosed invention, even with undue experimentation. The Wagner patent does not teach sufficient information to put the public in possession of the invention and to enable those skilled in the art to make and use the invention. There is nothing in the patent that informs the public how to use the invention and how to avoid infringement.

The Wagner Publication is non-enabling

The same previously discussed reasons as to why the Wagner Patent is non-enabling also apply to the Wagner Publication. Thus, the Wagner Publication is likewise non-enabling.

Additionally, subject matter disclosed in a parent application but not carried over into the child application cannot be relied on in a 35 U.S.C. § 102(e) rejection that applies the child application as the cited art (MPEP § 2136.02). It is respectfully submitted that this is the current situation. The subject matter discussed below that is “missing” from the Wagner Publication is not entitled to June 22, 1995 as the effective filing date.

As shown in more detail herein, Appellants also respectfully submit that this “missing” subject matter also renders the Wagner Publication non-enabling. The “missing” subject matter was necessary for an understanding of the invention. It follows that the non-enabling disclosure of the Wagner Publication (due to the missing subject matter) is also not entitled to June 22, 1995 as the effective filing date. That is, the disclosure of the Wagner Publication as a whole (without the missing subject matter) is not entitled to June 22, 1995 as the effective filing date.

The Wagner Publication lacks large amounts of subject matter that were disclosed in the Wagner Patent (U.S. Patent No. 5,742,845). The Wagner Publication is not entitled to this missing subject matter that was not carried over from the Wagner Patent. This missing subject matter is critical to the enablement of the Wagner Publication. The missing subject matter further renders the Wagner Publication non-enabling.

An example of missing subject matter can be found in the Wagner Patent at col. 12, line 20 after “mask,” to line 56 before “database”. This subject matter is “missing” from the Wagner Publication at page 7, paragraph 0065, line 17, between “mask,” and “database”. The subject matter missing from the Wagner Publication included 37 lines of description critical to the understanding and enablement thereof. Thus, the missing subject matter further renders the Wagner Publication non-enabling and not entitled to the June 22, 1995 date.

Review of reasons why the Wagner Publication does not constitute prior art

Appellants have shown that the relied upon features in the Wagner Publication do not find support in the Wagner patent, and thus cannot constitute prior art against Appellants’ recited invention.

Appellants have also shown that the Wagner patent is non-enabling. Thus, the Wagner Publication is not entitled to Wagner’s June 22, 1995 filing date.

Appellants have further shown that even if the Wagner patent was enabling, the Wagner Publication is non-enabling. Its lack of enablement renders the Wagner Publication inoperative as a valid prior art reference.

Rejection under 35 U.S.C. § 102(e) over the Wagner Publication

Claims 1, 3-4, 6-14, 16, 18-20, 22-26, 28, and 30 are rejected under 35 U.S.C. § 102(e) as being anticipated by the Wagner Publication. These rejections are respectfully traversed.

As previously discussed, the features relied upon in the Wagner Publication do not constitute prior art against Appellants' recited invention. Thus, the 35 U.S.C. § 102(e) rejections are not valid.

Nevertheless, even if it were somehow possible (which it is not) for the Wagner Publication to constitute prior art, the Wagner Publication still would not anticipate the claimed invention. Appellants' remarks concerning the claim rejections in no way waive their rights to have the rejections relying on the Wagner Publication stricken for the reasons already presented.

In order to avoid confusion regarding the sections of the Wagner Publication which do not constitute prior art, and in light of the Wagner Publication's applicability being limited to *only* subject matter previously taught in the Wagner Patent, for clarity the 35 U.S.C. § 102(e) rejections will be addressed with reference to the disclosure of the Wagner Patent (US 5,742,845). Of course, as previously discussed, the subject matter in the Wagner Patent at col. 12, line 20 after "mask," to line 56 before "database" is not available as prior art because it was not carried over into the applied Wagner Publication. Again, any reference to "Wagner" or the "Wagner patent" pertains to Wagner Patent (US 5,742,845), unless otherwise noted.

Wagner does not teach each and every feature, relationship and/or step of the claimed invention arranged in the manner recited in the claims, as is required to sustain the rejections. Wagner does not link automated banking machine operation responsive to a document in the manner recited. Wagner does not explicitly or inherently teach the recited features, relationships,

and/or steps. Thus, it is respectfully submitted that the 35 U.S.C. § 102(e) rejections should be withdrawn.

Claim 1

The Action is silent as to where the recited features and relationships are allegedly found in the Wagner Publication. Since the Action does not explain the rejection with reasonable specificity, it also procedurally fails to establish a case of anticipation. The Action's lack of use of the available reference numerals in the Wagner Publication is a further indication that the Wagner Publication does not anticipate the claims.

The Action (page 4, line 4) relies upon the features of claims 1-8, the Abstract, and paragraphs 0003 and 0020 in the Wagner Publication. However, as previously discussed, the relied upon features in claims 1-8 and the Abstract of the Wagner Publication do not find support in Wagner, and thus cannot constitute prior art against claim 1. The subject matter in the Wagner Publication that *does* actually constitute prior art (i.e., that subject matter found in Wagner sans the subject matter not carried over) does not anticipate recited claim 1. The subject matter in the Wagner Publication at relied upon paragraphs 0003 and 0020 does not anticipate claim 1.

Interpretation Note

Claim 1 recites an automated banking machine. The Action is silent as to what specific element in Wagner constitutes the recited automated banking machine. However, the Action relies on the Wagner Publication at claims 1-8 and the Abstract. These sections of the Wagner Publication refer to an ATM. Likewise, the Action at numbered paragraphs 7, 8, and 9 alleges an ATM as the recited automated banking machine. Thus, as best understood, the Office alleges an

ATM in Wagner as the recited automated banking machine. Thus, for reasons of brevity combined with the Office's alleged teaching of Wagner, Appellants hereafter may interchangeably refer to an "ATM" and an "automated banking machine" with regard to Wagner.

Wagner does not teach an *automated* banking machine

Claim 1 recites an *automated* banking machine. The recited automated banking machine includes an output device, an input device, a transaction function device, a computer, and software.

An ATM is *not* a part of Wagner's invention. Wagner mentions "ATM" at col. 1, lines 26, 29, 47, 60, 65; col. 2, line 1; and col. 4, line 24. That is, ATMs are mentioned only in the prior art Background section of Wagner. The term "ATM" mentioned at col. 12, line 19 is a typographical error, as it should read "AMT" to correspond with a purchase "amount" (as further evidenced in Figure 14, at section 1a, lines 18-19; col. 13, line 59; and col. 15, line 60).

Wagner also does not discuss ATM components or operation. Thus, reliance on an ATM in Wagner for the recited automated banking machine features and relationships is pure speculation, and has no basis. It follows that an ATM in Wagner cannot constitute the recited automated banking machine. Nor can Wagner anticipate the recited apparatus.

Nor can a PC or a non-standard I/O device in Wagner constitute the recited automated banking machine. Wagner (US 5,742,845) does not teach that a PC constitutes an automated banking machine. Contrarily, Wagner distinguishes a PC from an automated banking machine. Wagner teaches (and it is well known) that a PC is a *personal* computer (col. 1, line 31), whereas an ATM is a *special* purpose device (col. 1, lines 25-26). Wagner also distinguishes a PC from

an ATM by name. Nor does Wagner teach that his PC is *automated*. Thus, Wagner's PC cannot constitute the recited an automated banking machine.

Wagner also does not teach that a non-standard I/O device constitutes the recited automated banking machine. Wagner distinguishes non-standard I/O devices from an automated banking machine. Wagner distinguishes a non-standard I/O device from an ATM by name.

Wagner also distinguishes a non-standard I/O device from an ATM because non-standard I/O devices are devices that in the absence of the Wagner invention can couple to a PC through an interface such as an RS-232C interface (col. 4, lines 4-7; col. 3, lines 62-67). Wagner does not teach that an ATM couples to a PC through an RS-232C interface.

Wagner further distinguishes a non-standard I/O device from an ATM because non-standard I/O devices are devices which have been previously unsupported directly on a network (col. 5, lines 43-47; col. 6, lines 16-20). Wagner does not teach that an ATM has been unsupported on a network. Contrarily, ATMs have long been connected directly to proprietary networks.

It follows that an ATM does not meet Wagner's meaning (as best understood) of a *non-standard* I/O device. Unlike the non-standard I/O device examples provided in Wagner (which do not include an ATM), an ATM cannot constitute a non-standard I/O device. Thus, Wagner's non-standard I/O device cannot constitute the recited an automated banking machine.

Additionally, Wagner does not teach or suggest that an ATM is an I/O device. The Microsoft Computer Dictionary (e.g., 5th ed.) defines an I/O device as a separate piece of hardware, such as a disk drive. According to the Microsoft Computer Dictionary, an ATM is a far cry from an I/O device. Nor has the Office shown that one having ordinary skill in the art

would recognize an ATM as an I/O device, especially a “non-standard I/O device.” Furthermore, Wagner never states nor lists an ATM as a non-standard I/O device.

Wagner does not teach the software, computer, and transaction function device relationships

Where does Wagner teach that the ATM mentioned in his Background section can operate to carry out a transaction function responsive to ATM software processing an HTML document having an instruction that causes an ATM computer to cause operation of an ATM transaction function device? Wagner does not teach processing an HTML document instruction to cause an ATM computer to cause operation of an ATM transaction function device. Where does Wagner link operation of an ATM transaction function device to processing an HTML document with a browser? Wagner does not teach the recited features and relationships.

Even if it were somehow possible for an ATM in Wagner to have a computer with software (which somehow constituted the recited software), and a non-standard I/O device (which somehow constituted the recited transaction function device), Appellants respectfully submit that there would still remain fundamental differences between the apparatus recited in Appellants’ claim 1 and Wagner's system (as best understood). Specifically, Wagner does not teach that an automated banking machine *computer* acts “to *cause operation*” of an automated banking machine transaction function device. That is, Wagner does not teach that an ATM *computer* acts “to *cause operation*” of an ATM non-standard I/O device. Rather, Wagner teaches that it is his novel extended *protocol* that directly causes a non-standard I/O device to operate (col. 6, lines 12-13).

Wagner does not teach the structural relationship recited in Appellants' claim 1. Wagner provides no teaching whatsoever of his extended network protocol (which directly instructs a non-standard I/O device to operate) first instructing a computer (which would need to be intermediate the server and the non-standard I/O device), and then having that distinct intermediate computer instruct the non-standard I/O device to operate. Claim 1 requires the operation of a distinct intermediate computer that is absent in Wagner.

In claim 1 it is the *computer* that processes a HTML document having an instruction, then the *computer* causes the transaction function device to operate based on the processed instruction. In contrast, Wagner teaches that processing is carried out by the non-standard I/O device, not by a computer (PC). Wagner admits that a non-standard I/O device is not a computer (col. 4, lines 4-12; col. 5, lines 43-47; col. 9, lines 60-63). Wagner's non-standard I/O devices communicate *in* the extended protocol. In Wagner the extended protocol *directly* instructs a non-standard I/O device to operate. Wagner does not have an HTML document processing computer that instructs the non-standard I/O device to operate. Nor is an intermediate document processing computer even needed in Wagner. Nor does Wagner have an ATM document processing computer.

In Wagner a PC (if even needed) merely provides a pass through network connection for a non-standard I/O device that is capable of direct communication in the open network (col. 10, lines 33-36). In Wagner a PC is merely part of a circuitous communication path that helps pass messages therethrough to and from the network and the non-standard I/O device. That is, the information passes *through* the PC. For example, note the term "through" in Wagner's claim 17 and col. 5, lines 48-58 (particularly line 52). Wagner's non-standard I/O device is capable of

direct connection in the network. In Wagner a distinct ATM computer does not *process* an HTML document having an instruction, and then *cause* a distinct non-standard I/O device (in the ATM) to operate based on the processed instruction. Wagner's ATM lacks software with the ability to instruct an ATM computer to operate an ATM transaction function device in the manner recited. Wagner does not anticipate claim 1.

Appellants respectfully point out that the exemplary form of the invention advantageously permits the use of *standard* HTTP (not extended) protocol to cause operation of an ATM computer (not a non-standard I/O device), which computer operation causes operation of a transaction function device of the ATM. Thus, the transaction function device can be operated by the ATM computer to carry out its ATM function responsive to a processed HTML document instruction. Wagner does not anticipate claim 1.

In the recited invention of claim 1 the software executes to have an HTML document instruct the computer to act to cause operation of the ATM transaction function device. The instructed computer can act independently to initiate operation of the transaction function device. This enables the recited computer to receive a document including instructions using a *standard* Internet protocol (as opposed to Wagner's required extended protocol), then use a *proprietary* or other non-network internal ATM message protocol to operate the transaction function device (e.g., a currency sheet dispenser). Wagner's non-standard I/O devices are required to communicate in the special Wagner extended open network protocol. Neither the recited ATM computer nor the transaction function device of claim 1 require use of an extended protocol. For example, claim 1 permits use of a standard (not extended) protocol to communicate with an

ATM computer, which computer can then (without using an extended protocol) cause operation of a currency sheet dispenser. Wagner does not teach the recited abilities.

Again, in claim 1 the software is able to process an HTML document instruction that is able to “cause the computer to cause operation of the transaction function device.” It is the computer that is instructed (via the document instruction) to operate the transaction function device. That is, it is the *computer* that is instructed to act “to *cause operation* of the transaction function device.”

Wagner expressly teaches away from the recited invention of claim 1. Wagner’s non-standard I/O devices communicate in Wagner’s unique extended protocol. The extended open network protocol of Wagner permits a non-standard I/O device to be directly coupled to an open network so that it communicates with a server “as if the non-standard device were a PC on the network.” This ability was confirmed by Wagner in his prosecution history estoppel remarks presented in his application amendment filed 5/15/97 (at the paragraph bridging pages 6 and 7) in the prosecution history of the Wagner patent, as previously discussed. Wagner also expressly teaches that having a conventional non-standard I/O device communicate to a network through an intermediate PC is undesirable and presents a security risk because data input through the non-standard I/O device is accessible in the memory of the intermediate PC (col. 4, lines 28-32).

Wagner does not teach (nor does Wagner need) a network connected PC to instruct a non-standard I/O device to operate. If Wagner’s non-standard I/O device can directly receive (communicate in the open network) and process Wagner’s special messages in the special extended protocol, then why would a PC need to process such messages and then instruct the non-standard I/O device to operate? Alternatively, if Wagner’s PC processed instructions (which

it does not) which in turn caused the PC to operate the non-standard I/O device (which it does not), then why would Wagner's non-standard I/O device need to *communicate* in the extended protocol (which non-standard I/O device direct network communication ability is the heart of Wagner's invention)?

Wagner does not teach or suggest that a processed document instruction causes a computer to cause operation of a transaction function device, as recited in Appellants' claim 1. Rather, in Wagner a non-standard I/O device communicates in the extended open network protocol. This extended protocol enables a server to communicate directly with the non-standard I/O device (e.g., col. 6, lines 1-20). Wagner specifically teaches that his unique extended protocol "includes a command which *instructs* a non-standard I/O device" (col. 6, lines 12-13). That is, an extended protocol (sent from a remote server) directly instructs a non-standard I/O device to operate. Thus, in Wagner it is the extended *protocol* (not a PC nor an ATM *computer*) that causes the non-standard I/O device to operate.

Wagner's non-standard I/O devices do not need a PC to tell them when to operate. In Appellants' claim 1, operation of the transaction function device is dependent on a *computer* (which is dependent on an instruction in an HTML document instruction) initiating the operation. However, Wagner's non-standard I/O devices can be operated independent of a computer (PC). Wagner does not require the operation-causing intermediate computer of claim 1.

In Wagner a non-standard I/O device processes the information. This differs from claim 1, in which the ATM software causes the ATM computer to process the information then operate an ATM transaction function device (based on the processed information). It follows that

Wagner's non-standard I/O device also doesn't first need an HTML document instruction to cause a computer (PC) to cause the non-standard I/O device to operate.

As previously discussed, a PC in Wagner does not process an operation instruction which in turn causes the PC to cause operation of a non-standard I/O device. Furthermore, as admitted by Wagner, a non-standard I/O device does not constitute a computer. It follows that Wagner does not teach the recited software, computer, and transaction function device relationship. It further follows that Wagner does not anticipate claim 1.

Wagner does not teach the recited automated banking machine computer

Claim 1 recites an automated banking machine including a computer. As previously discussed, Wagner is silent regarding the components and operation of the ATM mentioned in his background section. Thus, reliance on an ATM in Wagner for having the recited computer is pure speculation, and has no basis. Wagner does not *teach* an ATM computer. It follows that Wagner cannot teach the recited computer. It further follows that an ATM in Wagner cannot constitute the recited automated banking machine.

Wagner's PC also cannot constitute the recited computer. Wagner does not teach an automated banking machine that *includes* a personal computer (PC).

Wagner's non-standard I/O device also cannot constitute the recited computer. Wagner teaches that a computer is not a non-standard I/O device. Wagner specifically distinguishes non-standard I/O devices from standard I/O devices (which include PCs) (col. 4, lines 4-12; col. 5, lines 43-47; col. 9, lines 60-63).

In Appellants' claim 1 the computer is in operative connection with an output device, an input device, and a transaction function device. There is no teaching in Wagner that an ATM

includes a computer that is distinct from an ATM output device, an ATM input device, and an ATM transaction function device. Wagner does not teach the recited computer.

Wagner does not teach the recited automated banking machine transaction function device

Claim 1 recites an automated banking machine including a transaction function device that “is selectively operative to carry out a transaction function . . . *responsive to* the browser processing at least one document including at least one instruction adapted to cause the computer to cause operation of the transaction function device.”

As previously discussed, Wagner is silent regarding the components and operation of the ATM mentioned in his Background section. Thus, reliance on an ATM in Wagner for the recited transaction function device is pure speculation, and has no basis. Wagner does not *teach* an ATM transaction function device.

A non-standard I/O device in Wagner cannot constitute the recited transaction function device. Where does Wagner teach an ATM including a non-standard I/O device? Where does Wagner teach an ATM non-standard I/O device that can carry out a transaction function in response to an ATM browser processing an HTML document having an instruction to cause an ATM computer to operate the non-standard I/O device? Where does Wagner teach that an ATM browser-processed HTML document instruction causes an ATM non-standard I/O device to operate to carry out a transaction function? Where does Wagner link the operation of a non-standard I/O device in an ATM to the processing of an HTML document with a browser of the ATM?

Wagner teaches that a non-standard I/O device is an I/O device that (outside of the context of Wagner’s invention) conventionally uses communication interfaces such as RS-232C

(col. 3, lines 62-64; col. 4, lines 4-7; col. 10, lines 5-6). The Office has presented no evidence of a transaction function device in an ATM using an RS-232C interface. The Office has not shown that a non-standard I/O device can structurally constitute an ATM transaction function device.

Appellants have presented reasons why a non-standard I/O device in Wagner cannot constitute the recited transaction function device. It follows that an ATM in Wagner cannot constitute the recited automated banking machine. A non-standard I/O device in Wagner cannot constitute any of the recited automated banking machine, the recited computer, or the recited transaction function device. Wagner does not anticipate the recited apparatus.

Wagner does not teach the recited software

Claim 1 recites an automated banking machine including software executable in the computer. As previously discussed, Wagner is silent regarding the components and operation of the ATM mentioned in his Background section. Thus, reliance on an ATM in Wagner for the recited software is pure speculation, and has no basis. Wagner does not *teach* ATM software. It follows that Wagner cannot teach the recited software. It further follows that an ATM in Wagner cannot constitute the recited automated banking machine.

Wagner also does not teach software executable in an automated banking machine computer, especially where the software includes a browser. Wagner does not teach a browser. Where does Wagner even mention a browser? Nor does Wagner teach a browser that can process HTML documents having instructions therein. Nor does Wagner teach an ATM browser that can process an HTML document instruction that causes an ATM computer to cause operation of an ATM transaction function device.

Furthermore, claim 1 specifically recites an output device and a transaction function device. An example of a transaction function device (36) is shown in Appellants' Figure 2. Even if it were somehow possible for an ATM in Wagner to have a browser to display web pages to an output device, there would still be no teaching that the browser would be related to operation of a transaction function device. That is, Wagner would still lack evidence of using a browser to process transaction function device operating instructions. Processing a document for display to an output device is different than processing a document instruction to cause operation of a transaction function device. Where does Wagner teach using an ATM browser to operate non display components? Where do Wagner's non-standard I/O devices require the use of a browser to operate? Even if it were somehow possible for Wagner to have an ATM with a non-standard I/O device, there would still be no teaching that the non-standard I/O device's operation would be dependent on an ATM browser processing a transaction function device operating instruction. Wagner teaches neither the recited software nor the recited transaction function device. A non-standard I/O device in Wagner cannot constitute the recited transaction function device. Additionally, Wagner appears to actually teach against using software (col. 2, lines 44-47 and 57-63).

Wagner does not teach the recited output device

Where does Wagner teach an automated banking machine including an output device? Wagner discloses that devices such as smart card reader (32), PIN pad (34), magnetic card swipe reader (36), and printer (38) may be coupled to PCs through a non-network port (col. 9, line 66 to col. 10, line 4). However, a smart card reader, PIN pad, and magnetic card swipe reader are each only an input device, not an output device.

Wagner also does not teach a printer (38) constituting the recited output device. Where does Wagner teach an automated banking machine printer that “outputs information, whereby a user is enabled to *perceive* outputs from the output device.” Even if it were somehow possible (obvious) for Wagner to have an ATM with a printer (which Wagner doesn’t teach), there is no teaching that the printer would enable an ATM user “to *perceive*” its printed output. For example, an internal printing within an ATM of transaction records would not enable an ATM user “to *perceive*” the internal printing. Thus, Wagner does not *teach* the recited output device.

Wagner does not explicitly or inherently teach the recited features and relationships. For all of these many reasons Wagner does not anticipate claim 1.

Claim 3

The Action relies upon claim 2 in the Wagner Publication. However, as previously discussed, the Wagner Publication’s claim 2 does not find support in the Wagner patent, and thus does not constitute prior art against recited claim 3. The subject matter in the Wagner Publication that actually constitutes prior art (i.e., that subject matter found in Wagner) does not anticipate recited claim 3.

Claim 3 depends from claim 1. Where does Wagner teach an ATM including the *combination* of an output device, an input device, and a transaction function device that comprises a card reader? Where does Wagner teach an ATM card reader that is operative to function responsive to an ATM browser processing a document instruction adapted to cause operation of the card reader? Wagner does not explicitly teach an automated banking machine including a transaction function device that comprises a card reader, especially an automated banking machine that can carry out a transaction function responsive to a browser-processed

document. Nor is the recited feature inherent in Wagner. The evidence of record must teach the recited features. *In re Zurko*, supra.

To establish inherency the Office must prove through citation to prior art that a card reader is “necessarily present” in an ATM in Wagner, and the ATM can carry out a transaction function responsive to a browser-processed document. The Office has not proved that the alleged feature is “necessarily present” in Wagner. Nor has the Office provided evidence (if somehow possible) that *every* ATM has a card reader, and *every* ATM can carry out a transaction function responsive to a browser-processed document. Inherency may not be established based on probabilities or possibilities (which apparently is the present situation). It is plainly improper to allege inherency based merely on the (speculative) possibility that Wagner could or might be used or operated in a manner not specifically disclosed. *In re Robertson*, supra. Appellants respectfully submit that the deficient nature of Wagner, and the lack of any other supporting evidence of record with regard to inherency, renders the rejection invalid. Wagner does not anticipate claim 3.

Claim 4

The Action relies upon claim 5 in the Wagner Publication. However, as previously discussed, the Wagner Publication’s claim 5 does not find support in Wagner, and thus does not constitute prior art against recited claim 4. The subject matter in the Wagner Publication that actually constitutes prior art (i.e., that subject matter found in Wagner) does not anticipate recited claim 4.

Claim 4 depends from claim 1. Where does Wagner teach an ATM printer that is operative to function responsive to an ATM browser processing a document instruction adapted

to cause operation of the printer? Wagner does not explicitly teach an automated banking machine including a transaction function device that comprises a printer, especially an automated banking machine that can carry out a transaction function responsive to a browser-processed document. Nor is the recited feature inherent in Wagner. The evidence of record must teach the recited features. *In re Zurko, supra*.

To establish inherency the Office must prove through citation to prior art that a printer is “necessarily present” in an ATM in Wagner, and that the ATM can carry out a transaction function responsive to a browser-processed document. The Office has not proved that the alleged feature is “necessarily present” in Wagner. Nor has the Office provided evidence (if somehow possible) that *every* ATM has a printer, and *every* ATM can carry out a transaction function responsive to a browser-processed document. The Office has not established inherency. *In re Robertson, supra*. Wagner does not anticipate claim 4.

Claim 6

The Action relies upon claim 4 in the Wagner Publication. However, as previously discussed, the Wagner Publication’s claim 4 does not find support in Wagner, and thus does not constitute prior art against recited claim 6. The subject matter in the Wagner Publication that actually constitutes prior art (i.e., that subject matter found in Wagner) does not anticipate recited claim 6.

Claim 6 depends from claim 1. Where does Wagner teach an ATM keyboard that is operative to function responsive to an ATM browser processing a document instruction adapted to cause operation of the keyboard? Wagner does not explicitly teach an automated banking machine including a transaction function device that comprises a keyboard, especially an

automated banking machine that can carry out a transaction function responsive to a browser-processed document. Nor is the recited feature inherent in Wagner. To present a legally valid rejection the evidence of record must teach the recited features. *In re Zurko, supra*.

To establish inherency the Office must prove through citation to prior art that a keyboard is “necessarily present” in an ATM in Wagner, and the ATM can carry out a transaction function responsive to a browser-processed document. The Office has not proved that the alleged feature is “necessarily present” in Wagner. In contrast, Wagner indicates use of a keypad or touch screen that has no association whatsoever with an ATM (col. 6, lines 41-46). Nor has the Office provided evidence (if somehow possible) that *every* ATM has a keyboard, and *every* ATM can carry out a transaction function responsive to a browser-processed document. The Office has not established inherency. *In re Robertson, supra*. Wagner does not anticipate claim 6.

Claim 7

The Action relies upon paragraph 0020 in the Wagner Publication. However, the subject matter in Wagner Publication's paragraph 0020 does not anticipate claim 7. Nor does the subject matter in the Wagner Publication that actually constitutes prior art (i.e., that subject matter found in the Wagner patent) anticipate recited claim 7.

Claim 7 depends from claim 1. Wagner does not explicitly teach an automated banking machine including software that can carry out a transaction function responsive to a browser-processed document. Wagner does not teach software that is operative responsive to an instruction to access at least one HTTP record address, wherein the at least one HTTP record address corresponds to at least one HTTP record including instructions adapted to cause the computer to cause operation of the transaction function device. Where does Wagner teach

automated banking machine software that can, in response to an HTML document instruction, access an address corresponding to an HTTP record that has (other) instructions that can cause a computer to cause operation of a transaction function device of the automated banking machine? Where does Wagner teach automated banking machine software that, in response to an HTML document instruction, accesses another instruction via an address corresponding to an HTTP record? Nor is the recited software inherent in Wagner. To present a valid rejection the evidence of record must teach the recited features. *In re Zurko, supra*.

To establish inherency the Office must prove through citation to prior art that the recited software is “necessarily present” in an ATM in Wagner. Wagner does not discuss ATM software. The Office has not proved that the alleged feature is “necessarily present” in Wagner. Nor has the Office provided evidence (if somehow possible) that *every* ATM has the recited software. The Office has not established inherency. *In re Robertson, supra*. Wagner does not anticipate claim 7.

Claim 8

The Action (on page 4) relies upon the features of claims 1-8, the Abstract, and paragraphs 0003 and 0020 in the Wagner Publication. However, as previously discussed, the relied upon features in claims 1-8 and the Abstract do not find support in the Wagner patent, and thus cannot constitute prior art against claim 8. The subject matter in the Wagner Publication that actually constitutes prior art (i.e., that subject matter found in Wagner) does not anticipate recited claim 8. The Wagner Publication at paragraphs 0003 and 0020 does not anticipate claim 8.

Appellants' remarks in support of the patentability of claim 1 are herein incorporated by reference. As previously discussed, as best understood, the Office alleges an ATM in Wagner as the recited automated banking machine. However, Wagner is silent regarding the components and operation of the ATM mentioned only in his Background section. Wagner does not teach an *ATM* including a *computer*. Wagner also does not teach an *ATM* including a *browser*. Where does Wagner even mention a browser? Nor does Wagner teach that responsive to at least one HTML format document received by the *ATM* browser, a transaction function device of the ATM is operative to cause the ATM to carry out a transaction function. Where does Wagner teach or suggest an ATM transaction function device that is operative to cause the ATM to carry out a transaction function responsive to at least one HTML document that is received by an ATM browser?

To establish inherency the Office must prove through citation to prior art that the recited *ATM* features are "necessarily present" in an ATM in Wagner. The Office has not proved that the alleged *ATM* features are "necessarily present" in Wagner. The Office has not established inherency. *In re Robertson, supra*. Wagner does not anticipate claim 8.

Claim 9

The Action (on pages 4 and 5) relies upon the features of claims 1-8, the Abstract, and paragraphs 0003 and 0020 in the Wagner Publication. However, as previously discussed, the relied upon features in claims 1-8 and the Abstract do not find support in the Wagner patent, and thus cannot constitute prior art against claim 9. The subject matter in the Wagner Publication that actually constitutes prior art (i.e., that subject matter found in Wagner) does not anticipate

recited claim 9. The Wagner Publication at paragraphs 0003 and 0020 does not anticipate claim 9.

Appellants' remarks in support of the patentability of claim 1 are herein incorporated by reference. As previously discussed, as best understood, the Office alleges an ATM in Wagner as the recited automated banking machine. Yet Wagner is silent regarding the components and operation of the ATM mentioned in his Background section.

Wagner does not teach operating a browser in at least one computer in connection with an automated banking machine. Where does Wagner even mention a browser?

Nor does Wagner teach receiving an HTML format document with a browser, where the HTML format document includes at least one transaction instruction. Where does Wagner teach a browser receiving an HTML format document that includes a transaction instruction?

Nor does Wagner teach carrying out a transaction function with a transaction function device in an automated banking machine responsive to the at least one HTML format document. Where does Wagner teach carrying out a transaction function with an ATM transaction function device in response to a browser receiving an HTML format document that includes a transaction instruction?

Nor has the Office proved that the recited method is "necessarily present" in Wagner. The Office has not established inherency. *In re Robertson, supra*. Wagner does not anticipate claim 9.

Claim 10

The Action (on page 5) relies upon lines 13-14 of paragraph 0004 in the Wagner Publication. The relied upon lines 13-14 state "In response to the message from the central

processing system, the remote terminal dispenses cash (for an ATM) or”. However, these lines do not anticipate recited claim 10. The relied upon lines 13-14 are a far cry from the recited step (d) of “producing an output through the output device responsive to the at least one HTML format document.”

ATMs existed prior to the Internet. It was well known for an ATM to receive a *message* to dispense cash. As Wagner’s prior art background section attests, a dedicated line was used (col. 1, lines 60-61). However, it is not previously known, nor does Wagner teach, having an ATM dispense cash responsive to receiving an *HTML format document*.

Claim 10 depends from claim 9. Wagner does not teach producing an output through an automated banking machine output device responsive to an HTML format document. Nor does Wagner teach both carrying out a transaction function and producing an output responsive to at least one HTML document. Where does Wagner teach carrying out a transaction function with an automated banking machine transaction function device *and* producing an output through an automated banking machine output device in response to at least one browser-received HTML format document that includes at least one instruction? Nor is the recited method inherent in Wagner. The evidence of record must teach the recited features. *In re Zurko, supra*.

Nor has the Office proved that the recited method is “necessarily present” in Wagner. The Office has not established inherency. *In re Robertson, supra*. Wagner does not anticipate claim 10.

Claim 11

The Action (on page 5) relies upon the features of claims 1-8, the Abstract, and paragraphs 0003 and 0020 in the Wagner Publication. However, as previously discussed, the

relied upon features in claims 1-8 and the Abstract do not find support in the Wagner patent, and thus cannot constitute prior art against claim 11. Furthermore, the subject matter in the Wagner Publication that actually constitutes prior art (i.e., that subject matter found in Wagner) does not anticipate recited claim 11. The subject matter in the Wagner Publication at paragraphs 0003 and 0020 does not anticipate claim 11.

Appellants' remarks in support of the patentability of claim 1 are herein incorporated by reference. As previously discussed, as best understood, the Office alleges an ATM in Wagner as the recited automated banking machine. Yet Wagner is silent regarding the components and operation of the ATM mentioned in his Background section.

Wagner does not teach operating a browser in at least one computer in operative connection with an automated banking machine. Where does Wagner even mention a browser?

Nor does Wagner teach receiving at least one document with the browser, where the document includes at least one transaction instruction embedded therein. Where does Wagner teach a browser receiving a document that includes an embedded transaction instruction?

Nor does Wagner teach carrying out a transaction function with a transaction function device in an automated banking machine responsive to a document having a transaction instruction embedded therein. Where does Wagner teach carrying out a transaction function with an automated banking machine transaction function device in response to a browser receiving a document that includes an embedded transaction instruction?

In claim 11 the document includes an *embedded* transaction instruction, whereas in Wagner the protocol is *extended* to instruct a non-standard I/O device (col. 6, lines 8-12). That is, in claim 11 the *instruction* is embedded in a document, whereas in Wagner the *instruction* is

in the extended protocol. In Wagner it is the extended *protocol* that causes the non-standard I/O device to operate. Where does Wagner teach an *embedded transaction instruction* in a *document*, especially where the document is received by a *browser* to carry out a transaction function with a *transaction function device* in an *automated banking machine*? Wagner does not teach the recited method.

Nor has the Office proved that the recited method is “necessarily present” in Wagner. The Office has not established inherency. *In re Robertson, supra*. Wagner does not anticipate claim 11.

Claim 12

The Action (on page 5) relies upon claims 1 and 7 in the Wagner Publication. However, as previously discussed, the relied upon claims 1 and 7 do not find support in the Wagner patent, and thus cannot constitute prior art against claim 12. The subject matter in the Wagner Publication that actually constitutes prior art (i.e., that subject matter found in Wagner) does not anticipate recited claim 12.

Appellants’ remarks in support of the patentability of claim 1 are herein incorporated by reference. As previously discussed, Wagner is silent regarding the components and operation of the ATM mentioned in his Background section. Wagner does not teach an ATM that operates to conduct at least one financial transaction responsive to at least one mark-up language document. Wagner does not teach the recited ATM/document/transaction relationship. Where does Wagner teach an ATM that operates to conduct a financial transaction responsive to a mark-up language document? Where does Wagner teach, in response to a mark-up language document, operating an ATM to conduct a financial transaction?

The Office also has not proved that the alleged features are “necessarily present” in Wagner. The Office has not established inherency. *In re Robertson, supra*. Wagner does not anticipate claim 12.

Claim 13

The Action (on page 5) relies upon the features of claims 1-8, the Abstract, and paragraphs 0003 and 0020 in the Wagner Publication. However, as previously discussed, the relied upon features in claims 1-8 and the Abstract do not find support in the Wagner patent, and thus cannot constitute prior art against claim 13. The subject matter in the Wagner Publication that actually constitutes prior art (i.e., that subject matter found in Wagner) does not anticipate recited claim 11. Furthermore, the subject matter in the Wagner Publication at paragraphs 0003 and 0020 does not anticipate claim 13.

Appellants’ remarks in support of the patentability of claim 1 are herein incorporated by reference. As previously discussed, it appears that the Office alleges an ATM as the recited automated banking machine. Yet Wagner is silent regarding the components and operation of the ATM mentioned in his Background section.

As previously discussed, Wagner does not teach an ATM comprising the recited computer, at least one transaction function device, and computer/transaction function device relationship. Wagner does not teach a computer that is able to cause a banking transaction to be carried out through operation of at least one automated banking machine transaction function device responsive to at least one mark up language document. Where does Wagner teach carrying out a banking transaction with an automated banking machine transaction function

device in response to a mark up language document? Wagner's ATM cannot constitute the recited automated banking machine.

Nor has the Office proved that the recited automated banking machine is "necessarily present" in Wagner. The Office has not established inherency. *In re Robertson, supra*. Wagner does not anticipate claim 13.

Claim 14

The Action (on page 6) relies upon the features of claims 1-8, the Abstract, and paragraphs 0003 and 0020 in the Wagner Publication. However, as previously discussed, the relied upon features in claims 1-8 and the Abstract do not find support in the Wagner patent, and thus cannot constitute prior art against claim 14. The subject matter in the Wagner Publication that actually constitutes prior art (i.e., that subject matter found in Wagner) does not anticipate recited claim 14. Nor does the subject matter in the Wagner Publication at paragraphs 0003 and 0020 anticipate claim 14.

Claim 14 depends from claim 13. Wagner further does not teach the recited software. Where does Wagner teach the use of document handling software? Wagner does not teach a computer including document handling software. Wagner does not teach that a computer is operative to carry out the at least one banking transaction responsive to the document handling software processing at least one mark up language document. Where does Wagner link carrying out a banking transaction to processing a mark up language document?

Nor has the Office proved that the recited software is "necessarily present" in Wagner. The Office has not established inherency. *In re Robertson, supra*. Wagner does not anticipate claim 14.

Claim 16

The Action (on page 6) relies upon the features of claims 1-8, the Abstract, and paragraphs 0003 and 0020 in the Wagner Publication. However, as previously discussed, the relied upon features in claims 1-8 and the Abstract do not find support in the Wagner patent, and thus cannot constitute prior art against claim 16. The subject matter in the Wagner Publication that actually constitutes prior art (i.e., that subject matter found in Wagner) does not anticipate recited claim 16. The subject matter in the Wagner Publication at paragraphs 0003 and 0020 does not anticipate claim 16.

Appellants' remarks in support of the patentability of claim 1 are herein incorporated by reference. As previously discussed, as best understood, the Office alleges an ATM in Wagner as the recited automated banking machine. Yet Wagner is silent regarding the components and operation of the ATM mentioned only in his Background section.

Wagner does not teach processing at least one mark up language document with a computer that is in operative connection with an automated banking machine including at least one transaction function device. Nor does Wagner teach carrying out at least a portion of a banking transaction with an automated banking machine transaction function device responsive to processing at least one mark up language document with a computer. Where does Wagner teach, in response to processing a mark up language document, carrying out at least a portion of a banking transaction with an automated banking machine transaction function device?

Nor has the Office proved that the recited method is "necessarily present" in Wagner. The Office has not established inherency. *In re Robertson, supra*. Wagner does not anticipate claim 16.

Claim 18

Claim 18 depends from claim 16. The Action (on page 6) relies upon claim 2 and paragraph 0015 in the Wagner Publication. However, as previously discussed, the relied upon claim 2 does not find support in the Wagner patent, and thus cannot constitute prior art against claim 18. The subject matter in the Wagner Publication that actually constitutes prior art (i.e., that subject matter found in Wagner) does not anticipate recited claim 18. Paragraph 0015 does not anticipate recited claim 18.

The relied upon paragraph 0015 does not teach reading indicia with an automated banking machine reading device responsive to processing a mark up language document. Paragraph 0015 is far cry from the recited step.

Wagner is silent regarding the components and operation of the ATM mentioned in his Background section. Wagner does not teach an ATM with a reading device. To present a valid rejection the evidence of record must *teach* the recited features. *In re Zurko, supra*. Even if it were somehow possible for Wagner to have an ATM reading device, Wagner still would not teach reading indicia with the reading device responsive to processing a mark up language document.

Nor has the Office proved that the recited method is “necessarily present” in Wagner. The Office has not established inherency. *In re Robertson, supra*. Wagner does not anticipate claim 18.

Claim 19

Claim 19 depends from claim 18/16. Wagner further does not teach reading indicia from a card with an automated banking machine card reader responsive to processing a mark up

language document. Wagner is silent regarding the components and operation of the ATM mentioned in his Background section. Wagner does not teach an ATM including a card reader. Paragraph 0015 of the Wagner Publication is far cry from the recited step.

The Office also has not proved that the recited method is “necessarily present” in Wagner. The Office has not established inherency. *In re Robertson, supra*. Thus, Wagner does not anticipate claim 19.

Claim 20

Claim 20 depends from claim 16. The Action (on page 6) relies upon lines 13-14 of paragraph 0004 in the Wagner Publication. The relied upon lines 13-14 state “In response to the message from the central processing system, the remote terminal dispenses cash (for an ATM) or”. However, these lines do not anticipate recited claim 18. The relied upon lines 13-14 are a far cry from carrying out at least a portion (sensing input through at least one key) of a banking transaction with an automated banking machine transaction function device (including at least one key) responsive to processing at least one mark up language document with a computer. Where does Wagner teach sensing input through at least one automated banking machine transaction function device key responsive to mark up language document processing?

Nor has the Office proved that the recited method is “necessarily present” in Wagner. The Office has not established inherency. *In re Robertson, supra*. Wagner does not anticipate claim 20.

Claim 22

Claim 22 depends from claim 16. The Action (on page 7) again relies upon lines 13-14 of paragraph 0004 in the Wagner Publication. The relied upon lines 13-14 state “In response to

the message from the central processing system, the remote terminal dispenses cash (for an ATM) or”. However, these lines do not anticipate the features and relationships recited in claim 22.

The relied upon lines 13-14 are a far cry from carrying out at least a portion of a banking transaction with an automated banking machine transaction function device responsive to processing at least one mark up language document with a computer *and* providing at least one output through an automated banking machine output device responsive to processing at least one mark up language document with the computer. Wagner does not teach both carrying out at least a portion of a banking transaction with a transaction function device and providing an output through an output device responsive to processing at least one mark up language document with a computer. Where does Wagner teach carrying out at least a portion of an automated banking machine transaction *and* providing at least one automated banking machine output in response to processing at least one mark up language document? Nor has the Office established inherency. Wagner does not anticipate claim 22.

Claim 23

Claim 23 depends from claim 22/16. Wagner further does not teach providing at least one automated banking machine output responsive to browser software processing at least one mark up language document. For reasons previously discussed, the relied upon claims 1-7 in the Wagner Publication do not constitute prior art against claim 23. The teaching in relied upon lines 13-14 in paragraph 0004 of the Wagner Publication is a far cry from the recited method.

Wagner is silent regarding the components and operation of the ATM mentioned in his Background section. Wagner does not teach an ATM providing an output in response to browser

software processing at least one mark up language document. Where does Wagner even mention a browser? Nor has the Office established inherency. Wagner does not anticipate claim 23.

Claim 24

Claim 24 depends from claim 23/22/16. Wagner further does not teach providing a visual output through an automated banking machine output device screen responsive to browser software processing at least one mark up language document. The relied upon paragraph 0019 of the Wagner Publication does not teach the recited method.

Wagner is silent regarding the components and operation of the ATM mentioned in his Background section. Wagner does not teach an ATM providing a visual output in response to browser software processing at least one mark up language document. The relied upon paragraph 0019 in the Wagner Publication does not even mention an ATM. Nor has the Office established inherency. Wagner does not anticipate claim 24.

Claim 25

Claim 25 depends from claim 16. The Action (on page 7) relies upon claims 1 and 7 in the Wagner Publication. However, as previously discussed, these relied upon claims do not find support in the Wagner patent, and thus cannot constitute prior art against claim 25. The subject matter in the Wagner Publication that actually constitutes prior art (i.e., that subject matter found in Wagner) does not anticipate claim 25.

Wagner is silent regarding the components and operation of the ATM mentioned in his Background section. Wagner does not teach processing at least one HTML document to cause the carrying out of at least a portion of a banking transaction with an ATM transaction function device. Nor has the Office proved that the recited method is “necessarily present” in Wagner.

The Office has not established inherency. *In re Robertson, supra*. Wagner does not anticipate claim 25.

Claim 26

Claim 26 depends from claim 16. The Action (on page 7) relies upon claims 1, 5, 7 and 13-14 in paragraph 0004 of the Wagner Publication. For reasons previously discussed, these relied upon claims do not constitute prior art against claim 26. The relied upon lines 13-14 state “In response to the message from the central processing system, the remote terminal dispenses cash (for an ATM) or”. However, these lines do not anticipate recited claim 26. The subject matter in the Wagner Publication that actually constitutes prior art (i.e., that subject matter found in Wagner) does not anticipate recited claim 26.

Wagner is silent regarding the components and operation of the ATM mentioned in his Background section. Wagner does not teach that the processing at least one mark up language document is operative to *both* cause the carrying out of at least a portion of a banking transaction with a transaction function device of an ATM *and* to provide an output through an output device of the ATM. Wagner does not teach both carrying out at least a portion of a banking transaction and providing an output in response to processing at least one mark up language document. Nor has the Office proved that the recited method is “necessarily present” in Wagner. The Office has not established inherency. *In re Robertson, supra*. Wagner does not anticipate claim 26.

Claim 27

The Action (on page 10) *admits* (in the 35 U.S.C. § 103(a) rejection of claim 27) that the Wagner Publication does not teach all of the recited features of claim 27. Appellants concur that Wagner does not anticipate claim 27.

Claim 28

Claim 28 depends from claim 14/13. The Action (on page 6) relies upon the features of claims 1-8, the Abstract, and paragraphs 0003 and 0020 in the Wagner Publication. However, as previously discussed, the relied upon features in claims 1-8 and the Abstract do not find support in the Wagner patent, and thus cannot constitute prior art against claim 28. The subject matter in the Wagner Publication that actually constitutes prior art (i.e., that subject matter found in Wagner) does not anticipate recited claim 28. The subject matter in the Wagner Publication at paragraphs 0003 and 0020 does not anticipate claim 28.

Wagner further does not teach the recited browser. Where does Wagner even mention a browser? Where does Wagner teach the use of document handling software? Even if Wagner had document handling software, where does Wagner teach that *all* document handling software includes a browser?

Nor does Wagner teach an automated banking machine computer that can *automatically* operate a transaction function device responsive to the processing of at least one mark up language document. An ATM in Wagner does not constitute the recited automated banking machine. Where does Wagner link automatic operation of an ATM transaction function device to processing a mark up language document, especially with a browser? Nor has the Office proved that the recited automated banking machine is “necessarily present” in Wagner. The Office has not established inherency. *In re Robertson, supra*. Wagner does not anticipate claim 28.

Claim 30

Claim 30 depends from claim 13. The Action (on page 7) relies upon claims 1 and 7, and paragraph 0019 in the Wagner Publication. However, as previously discussed, the relied upon features in claims 1 and 7 do not constitute prior art against claim 30. The subject matter in the Wagner Publication that actually constitutes prior art (i.e., that subject matter found in Wagner) does not anticipate recited claim 30. The subject matter in the Wagner Publication at paragraph 0019 does not anticipate claim 30. The relied upon paragraph 0019 does not even mention an ATM.

As previously discussed, as best understood, the Office alleges an ATM in Wagner as the recited automated banking machine. Yet Wagner is silent regarding the components and operation of the ATM mentioned in his Background section. Where does Wagner teach the use of document handling software? Where does Wagner teach an ATM computer including document handling software? Wagner does not teach an ATM computer with document handling software that can *automatically* display a visual output through a display screen of the ATM responsive to processing at least one mark up language document with the computer. Where does Wagner teach an ATM computer that is operative both to cause a banking transaction to be carried out through operation of an ATM transaction function device responsive to at least one mark up language document, and to automatically display at least one visual output through a display device responsive to processing of the at least one mark up language document? Nor has the Office established inherency. *In re Robertson, supra*. Wagner does not anticipate claim 30.

The 35 U.S.C. § 103 (a) Rejections

The Applicable Legal Standards

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features and relationships of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142 (Eighth Edition, August 2001; Rev. 2, May 2004).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

A determination of patentability must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

The 35 U.S.C. § 103(a) Rejections are legally improper

The alleged modification of Wagner is based solely on hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). Likewise, the attempt to combine the teachings of Wagner and Russell is another attempt at hindsight reconstruction of Appellants' claimed invention. The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Appellants' disclosure. It follows that it would not have been obvious to have modified the reference(s) in the manner alleged. Furthermore, without a motivation to combine, which is the current situation, a rejection based on a *prima facie* case of obviousness is improper (MPEP § 2143.01).

Appellants traverse the rejections on the grounds that Appellants' claims recite features, relationships, and/or steps which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features, relationships, and/or steps recited in Appellants' claims patentably distinguish over the applied reference(s). Nor would it have been obvious to one having ordinary skill in the art to have combined the teachings of the reference(s) to have produced the recited invention. The Office does not factually support any *prima facie* conclusion of obviousness. To establish *prima facie* obviousness, the prior art must teach or suggest *all* the claim limitations. If the Office does

not produce a *prima facie* case, which is the current situation, then the Appellants are under no obligation to submit evidence of nonobviousness (MPEP § 2142). Thus, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections should be withdrawn.

Additional Comments Regarding The 35 U.S.C. § 103(a) Rejections

Appellants respectfully submit that the Action does not correctly ascertain the level of one having ordinary skill in the art, to which the claimed subject matter pertains, at the time of the invention. That is, the level of one having ordinary skill in the art is at least limited to that knowledge which was publically known prior to July 7, 1996 (note Appellants' Declaration). Appellants' Declaration (filed on February 4, 2002) swears back prior to July 7, 1996. Appellants' effective filing date (and the Declaration) was already addressed in the previous Board decision regarding this application.

There is no indication that the Office stepped backward in time to when the invention was unknown and just before it was made to make its determination of reasons for modifying Wagner (and obviousness). The Action's reasons for modifying Wagner lack the required prior art showing of knowledge and rationale necessary to maintain the rejections. Appellants respectfully submit that the Office did not reach a conclusion based on facts gleaned only from the *prior* art. That is, the Office incorrectly applied the level of one having ordinary skill in the art of today, especially in relation to use of HTML documents for causing the operation of a transaction function device in an ATM. For these additional reasons, Appellants respectfully submit that the rejections should be withdrawn.

The Pending Claims Are Not Obvious Over The Wagner Publication

In the Action claims 2, 5, 15, 17, 21, and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Wagner Publication. These rejections are respectfully traversed.

The independent claims from which these claims depend have been previously shown to be allowable. Thus, it is asserted that these dependent claims are allowable on the same basis. Furthermore, each of these dependent claims additionally recites specific features and relationships that patentably distinguish the claimed invention over the applied art.

The Wagner Publication does not teach or suggest the recited features and relationships. Nor would it have been obvious to one having ordinary skill in the art to have modified Wagner as alleged to have produced the claimed invention. The Action does not establish a *prima facie* showing of obviousness. Therefore, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejections should be withdrawn.

Claim 2

The Action alleges an ATM in the Wagner Publication as the recited automated banking machine. The Action *admits* (on page 8) that the Wagner Publication does not explicitly teach an ATM comprising a *sheet* dispenser. The Action alleges that the Wagner Publication inherently teaches an ATM comprising a sheet dispenser.

The Action relies upon claim 1 and paragraph 0004 in the Wagner Publication (i.e., the Wagner patent paragraph at col. 1, lines 34-57). However, for reasons previously discussed, the relied upon features in claim 1 of the Wagner Publication do not constitute prior art against

recited claim 2. The subject matter in the Wagner Publication that actually constitutes prior art (i.e., that subject matter found in the Wagner patent) does not teach or suggest recited claim 2. The subject matter in relied upon paragraph 0004 does not teach or suggest recited claim 2.

Wagner (nor the Wagner Publication) does not inherently teach an ATM comprising a sheet dispenser. Paragraph 0004 at line 14 the Wagner Publication refers to “dispenses cash (for an ATM)”. However, the Office has presented no evidence that Wagner's mentioned “cash” includes a “sheet”. What prevents the mentioned “cash” in paragraph 0004 from being a “coin” or “coins”?

To establish inherency the Office must prove through citation to prior art that a cash “sheet” is “necessarily present” in the Wagner Publication. Wagner (nor the Wagner Publication) does not mention “sheet”, “bill”, or “note”. Nor does Wagner prevent the mentioned “cash” in paragraph 0004 from being limited to a “coin” or “coins”. The Office has not proved that a cash “sheet” is “necessarily present” in Wagner. Thus, the Office has not established inherency. *In re Robertson, supra*. The lack of a 35 U.S.C. § 102 rejection against recited claim 2 also infers lack of inherency.

The Action (on page 8) also alleges that “it is known in the art that an ATM comprises a sheet dispenser.” The Action further alleges that it would have been obvious to modify the ATM of Wagner with a sheet dispenser. An assertion of basic knowledge and common sense not based on any evidence in the record (which is the current situation) lacks substantial evidence support. *In re Zurko, supra*.

Wagner (nor the Wagner Publication) *alone* does not teach or suggest the recited apparatus. Even if it were somehow possible to have modified an ATM in Wagner to have

included a sheet dispenser (as alleged), Wagner still would not teach or suggest the recited apparatus. A modified Wagner still would not teach or suggest that the ATM sheet dispenser would function responsive to a browser processing an HTML document having an instruction that causes operation of the sheet dispenser. Where does Wagner teach the dispensing of a sheet through operation of an ATM sheet dispenser responsive to at least one HTML document? Wagner (even if modified as alleged) does not link operation of an ATM sheet dispenser to processing an HTML document.

The Office has not established a *prima facie* showing of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified Wagner as alleged to have produced the recited apparatus.

Claim 5

The Action alleges an ATM in the Wagner Publication as the recited automated banking machine. The Action *admits* (on page 8) that the Wagner Publication does not expressly teach an ATM comprising a *depository*. The Action alleges that the Wagner Publication inherently teaches an ATM comprising a depository.

The Action relies upon claim 1 and paragraph 0004 in the Wagner Publication (i.e., the Wagner patent paragraph at col. 1, lines 34-57). For reasons previously discussed, the relied upon features in claim 1 of the Wagner Publication do not constitute prior art against recited claim 5. The subject matter in the Wagner Publication that actually constitutes prior art (i.e., that subject matter found in the Wagner patent) does not teach or suggest recited claim 5. The subject matter in relied upon paragraph 0004 does not teach or suggest recited claim 5.

Wagner does not inherently teach an ATM comprising a depository. To establish inherency the Office must prove through citation to prior art that a depository is “necessarily present” in the Wagner patent. Paragraph 0004 does *not* teach or suggest a depository. Wagner does not even mention a depository. The Office has not proved that a depository is “necessarily present” in Wagner. Thus, the Office has not established inherency. *In re Robertson, supra*. The lack of a 35 U.S.C. § 102 rejection against recited claim 5 also infers lack of inherency.

The Action (on page 8) also alleges that “it is known in the art that an ATM comprises a depository.” The Action further alleges that it would have been obvious to modify the ATM of Wagner with a depository.

An assertion of basic knowledge and common sense not based on any evidence in the record (which is the current situation) lacks substantial evidence support. *In re Zurko, supra*. The Action is silent as to any teaching or suggestion in Wagner (the only applied teaching) as to whether his ATM could be modified to include a depository. Nor does the Action explain how an ATM in Wagner would be structurally modified to include a depository. Nor has the Office provided evidence (if somehow possible) that *every* ATM has a depository. Contrarily, it is known to have an ATM without a depository. For example, an ATM may have only a cash dispenser, without having a depository (Appellants’ specification at page 17, last line to page 18, first line). Thus, the record lacks substantial evidence support.

Wagner alone does not teach or suggest the recited apparatus. Even if it were somehow possible to have modified an ATM in Wagner to have included a depository (as alleged), Wagner still would not teach or suggest the recited apparatus. A modified Wagner still would not teach or suggest that the ATM depository would function responsive to a browser processing an HTML

document having an instruction to cause operation of the depository. Wagner (even if modified as alleged) does not link operation of an ATM depository to processing an HTML document.

The Office has not established a *prima facie* showing of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified Wagner as alleged to have produced the recited apparatus.

Claim 15

Claim 15 depends from claim 13. The Action *admits* (on page 8, last line) that the Wagner Publication does not explicitly teach an ATM comprising a *note* dispenser. The Action alleges that the Wagner Publication inherently teaches an ATM comprising a note dispenser.

The Action relies upon claim 1 and paragraph 0004 in the Wagner Publication (i.e., the Wagner patent at col. 1, lines 34-57). However, for reasons previously discussed, the relied upon features in claim 1 of the Wagner Publication do not constitute prior art against recited claim 15. The subject matter in the Wagner Publication that actually constitutes prior art (i.e., that subject matter found in Wagner) does not teach or suggest recited claim 15. The subject matter in relied upon paragraph 0004 does not teach or suggest recited claim 15.

Wagner does not inherently teach an ATM comprising a note dispenser. Paragraph 0004 at line 14 refers to “dispenses cash (for an ATM)”. However, the Office has presented no evidence that Wagner’s mentioned “cash” includes a “note”. What prevents the mentioned “cash” in paragraph 0004 from being a “coin” or “coins”?

To establish inherency the Office must prove through citation to prior art that a cash “note” is “necessarily present” in the Wagner patent. Wagner does not mention “note”, “bill”, or “sheet”. Nor does Wagner prevent the mentioned “cash” in paragraph 0004 from being limited

to a “coin” or “coins”. The Office has not proved that a cash “note” is “necessarily present” in Wagner. Thus, the Office has not established inherency. *In re Robertson, supra*. The lack of a 35 U.S.C. § 102 rejection against recited claim 15 also infers lack of inherency.

The Action (on page 8) also alleges that “it is known in the art that an ATM comprises a note dispenser.” The Action further alleges that it would have been obvious to modify the ATM of Wagner with a note dispenser.

Wagner *alone* has been applied. An assertion of basic knowledge and common sense not based on any evidence in the record (which is the current situation) lacks substantial evidence support. *In re Zurko, supra*.

Wagner alone does not teach or suggest the recited apparatus. Even if it were somehow possible to have modified an ATM in Wagner to have included a note dispenser (as alleged), Wagner still would not teach or suggest the recited apparatus. A modified Wagner still would not teach or suggest that the ATM note dispenser would dispense a note responsive to at least one mark up language document. Where does Wagner teach dispensing a note responsive to a mark up language document? Wagner (even if modified as alleged) does not link ATM note dispensing to a mark up language document.

The Office has not established a *prima facie* showing of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified Wagner as alleged to have produced the recited apparatus.

Claim 17

Claim 17 depends from claim 16. The Action *admits* (on page 9) that the Wagner Publication does not explicitly teach an ATM comprising a *note* dispenser. The Action alleges that the Wagner Publication inherently teaches an ATM comprising a note dispenser.

The Action relies upon claim 1 and paragraph 0004 in the Wagner Publication (i.e., the Wagner patent at col. 1, lines 34-57). However, for reasons previously discussed, the relied upon features in claim 1 of the Wagner Publication do not constitute prior art against recited claim 17. The subject matter in the Wagner Publication that actually constitutes prior art (i.e., that subject matter found in Wagner) does not teach or suggest recited claim 17. The subject matter in relied upon paragraph 0004 does not teach or suggest recited claim 17.

Wagner does not inherently teach an ATM comprising a note dispenser. Paragraph 0004 at line 14 refers to “dispenses cash (for an ATM)”. However, the Office has presented no evidence that Wagner’s mentioned “cash” includes a “note”. What prevents the mentioned “cash” in paragraph 0004 from being a “coin” or “coins”?

To establish inherency the Office must prove through citation to prior art that a cash “note” is “necessarily present” in the Wagner patent. Wagner does not mention “note”, “bill”, or “sheet”. Nor does Wagner prevent the mentioned “cash” in paragraph 0004 from being limited to a “coin” or “coins”. The Office has not proved that a cash “note” is “necessarily present” in Wagner. Thus, the Office has not established inherency. *In re Robertson, supra*. The lack of a 35 U.S.C. § 102 rejection against recited claim 17 also infers lack of inherency.

The Action (on page 9) also alleges that “it is known in the art that an ATM comprises a note dispenser.” The Action further alleges that it would have been obvious to modify the ATM of Wagner with a note dispenser.

An assertion of basic knowledge and common sense not based on any evidence in the record (which is the current situation) lacks substantial evidence support. *In re Zurko, supra*.

Wagner alone does not teach or suggest the recited method. Even if it were somehow possible to have modified an ATM in Wagner to have included a note dispenser (as alleged), Wagner still would not teach or suggest the recited method. A modified Wagner still would not teach or suggest that the ATM note dispenser would dispense a note responsive to processing at least one mark up language document. Where does Wagner teach dispensing a note responsive to processing a mark up language document? Wagner (even if modified as alleged) does not link ATM note dispensing to processing a mark up language document.

The Office has not established a *prima facie* showing of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified Wagner as alleged to have produced the recited method.

Claim 21

Claim 21 depends from claim 16. Appellants’ remarks in support of the patentability of claim 5 are herein incorporated by reference. The Action *admits* (on page 8) that the Wagner Publication does not expressly teach an ATM comprising a *depository*. As previously discussed (claim 5 remarks), Wagner also does not inherently teach an ATM comprising a depository.

As previously discussed the Wagner Publication is, with regard to virtually all features dealing with ATMs, not prior art with regard to the present invention. The teachings of the

Wagner patent are the only teachings relevant to the analysis. It would not have been obvious to have modified the ATM of *Wagner* with a depository. The Wagner Publication alone has been applied. The Action admits that the Wagner Publication (and Wagner) *alone* does not teach the recited depository. No other evidence of record has been presented. Nor has the Office provided evidence (if somehow possible) that *every* ATM has a depository. Contrarily, Appellants respectfully submit that there are ATMs without a depository. Thus, the record lacks substantial evidence support. *In re Zurko, supra*.

The Action is silent as to any teaching or suggestion that an ATM in Wagner could be modified to include a depository. Nor does the Action explain how an ATM in Wagner would be structurally modified to include a depository.

Even if it were somehow possible to have modified an ATM in Wagner to have included a depository, Wagner still would not teach or suggest the recited method. A modified Wagner still would not teach or suggest receiving a deposit with the ATM depository responsive to processing at least one mark up language document. Where does Wagner teach receiving a deposit with a depository responsive to processing a mark up language document?

The Office has not established a *prima facie* showing of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified Wagner as alleged to have produced the recited method.

Claim 28

Claim 28 depends from claim 14/13. Appellants' previous remarks against the 35 U.S.C. § 102 rejection of claim 28 are herein incorporated by reference.

The Wagner Publication is not prior art to the present invention. Wagner does not teach or suggest the recited apparatus. Nor would it have been obvious to have modified the ATM of *Wagner* to automatically operate at least one transaction function device responsive to the processing of at least one mark up language document with a browser. The Action is silent as to any teaching or suggestion for modifying an ATM in Wagner in the manner recited. The Office has not established a *prima facie* showing of obviousness.

Claim 29

Claim 29 depends from claim 28/14/13. The Action *admits* (on page 9) that the Wagner Publication does not explicitly teach an ATM comprising a currency *sheet* dispenser. The Action alleges that the Wagner Publication inherently teaches an ATM comprising a currency *sheet* dispenser.

The Action relies upon claim 1 and paragraph 0004 in the Wagner Publication (i.e., Wagner paragraph at col. 1, lines 34-57). However, for reasons previously discussed, the relied upon features in claim 1 of the Wagner Publication do not constitute prior art against recited claim 29. The subject matter in the Wagner Publication that actually constitutes prior art (i.e., that subject matter found in the Wagner patent) does not teach or suggest recited claim 29. The subject matter in relied upon paragraph 0004 does not teach or suggest recited claim 29.

Wagner does not inherently teach an ATM comprising a currency *sheet* dispenser. Paragraph 0004 at line 14 refers to “dispenses cash (for an ATM)”. However, the Office has presented no evidence that Wagner’s mentioned “cash” includes a “currency sheet”. What prevents the mentioned “cash” in paragraph 0004 from being a “coin” or “coins”?

To establish inherency the Office must prove through citation to prior art that a cash “currency sheet” is “necessarily present” in the Wagner Publication. Wagner does not mention “currency sheet”, “note”, “bill”, or “sheet”. Nor does Wagner prevent the mentioned “cash” in paragraph 0004 from being limited to a “coin” or “coins”. The Office has not proved that a cash “currency sheet” is “necessarily present” in Wagner. Thus, the Office has not established inherency. *In re Robertson, supra*. The lack of a 35 U.S.C. § 102 rejection against recited claim 29 also infers lack of inherency.

The Action (on page 9) also alleges that “it is known in the art that an ATM comprises a currency sheet dispenser.” The Action further alleges that it would have been obvious to modify the ATM of Wagner with a currency sheet dispenser.

The Wagner Publication *alone* has been applied. An assertion of basic knowledge and common sense not based on any evidence in the record (which is the current situation) lacks substantial evidence support. *In re Zurko, supra*.

Wagner alone does not teach or suggest the recited apparatus. Even if it were somehow possible to have modified an ATM in Wagner to have included a currency sheet dispenser (as alleged), Wagner still would not teach or suggest the recited apparatus. A modified Wagner still would not teach or suggest that the ATM currency sheet dispenser would dispense a currency sheet responsive to processing at least one mark up language document with a browser. Wagner (even if modified as alleged) does not link ATM currency sheet dispensing to a browser-processed mark up language document.

The Office has not established a *prima facie* showing of obviousness. The Wagner Publication is not prior art. It would not have been obvious to one having ordinary skill in the art to have modified Wagner as alleged to have produced the recited apparatus.

**The pending claim 27 is not obvious over the
Wagner Publication in view of Russell**

In the Action claim 27 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the Wagner Publication in view of Russell. This rejection is respectfully traversed.

Claim 27 recites:

The method according to claim 16 wherein the computer is operative to cause the carrying out of the portion of the banking transaction responsive to at least one software applet.

Russell

Russell is directed to a system for carrying out information transactions using Web documents. A URL (Uniform Resource Location) encoded as a bar code (8), is able to be read by a bar code reader (7A). The bar code is decoded and the URL is used to access a document whose location is specified by the URL. Particularly note Figures 1 and 1B.

Russell does not constitute prior art

The Action relies Russell at col. 6, lines 39-46 and col. 21, lines 43-45. The relied upon sections of Russell relate to a “Java-Applet.” However, Appellants respectfully submit that the relied upon “Java-Applet” subject matter does not constitute prior art against recited claim 27.

The Russell patent has a filing date of August 22, 1997. The present invention is entitled to (and claims benefit of) the November 27, 1996 filing date of provisional application 60/031,956. Additionally, if necessary, Appellants’ Declaration (filed on February 4, 2002)

swears back prior to July 7, 1996. Appellants' effective filing date (and the Declaration) was already addressed in the previous Board decision regarding this application.

The Russell patent is a continuation-in-part of many other applications, some of which themselves are a continuation-in-part of another application. Appellants respectfully submit that (upon closer review) the earliest effective filing date that provided support in Russell for the relied upon "Java-Applet" subject matter belonged to application 08/869,164 (now U.S. Patent No. 5,992,752). Application 08/869,164 had a June 4, 1997 filing date. However, Appellants' November 27, 1996 provisional filing date (and the swear behind date prior to July 7, 1996) predates Russell's effective date of June 4, 1997.

Appellants have shown the strong likelihood that the subject matter relied upon in Russell is *not* prior art to recited claim 27. The Office has presented absolutely no evidence of record that the subject matter relied upon in Russell is prior art. Appellants are entitled to a showing of facts, not mere allegations (which is the present situation). *In re Zurko, supra*. *In re Lee, supra*.

The Appellants are not required to prove patentability. Contrarily, it is the Office which must show non patentability under the law. The evidence of record does not support the legality of Russell as prior art with regard to the rejection of claim 27.

As Russell does not constitute prior art, the rejection of claim 27 is not legally valid. Appellants "may overcome a 35 U.S.C. § 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of *any* of the references" (MPEP § 715.02 (I)).

Likewise as discussed in detail previously, the Wagner Publication is also not prior art to the present invention.

Claim 27

Even if it were somehow possible for Russell to constitute prior art against claim 27, the Action still has not established a *prima facie* showing of obviousness. Appellants' remarks concerning the claim 27 rejection in no way waive their rights to have the rejection relying on Russell and the Wagner Publication stricken for the reasons already presented.

Claim 27 depends from claim 16. Claim 16 at step (c) recites "carrying out at least a portion of a banking transaction with the transaction function device responsive to processing the at least one mark up language document with the computer." Claim 27 further recites that "the computer is operative to cause the carrying out of the portion of the banking transaction responsive to at least one software applet."

The Action admits (on page 10) that Wagner does not teach that a "function device includes executing software applet instructions." The Action alleges that Russell teaches the method features and relationships admitted as absent in the Wagner Publication. Appellants respectfully disagree.

Russell does not disclose or suggest the recited features and relationships which are not found in Wagner (nor the Wagner Publication). Russell (like Wagner) does not teach or suggest the step of carrying out of a portion of a banking transaction with an automated banking machine transaction function device responsive to at least one software applet? Where does Russell teach, in response to a software applet, carrying out at least a portion of a banking transaction with an automated banking machine transaction function device? Russell does not teach using URL-encoded bar codes with ATMs. Russell's desire for a generic Internet kiosk teaches away from using specialized machines like ATMs (col. 2, lines 1-15).

The Action is silent as to how an ATM of Wagner could be modified by the teaching of Russell. Nor is there any motivation to combine. Neither reference teaches modifying a non standard I/O device in Wagner for use with Russell's URL-encoded bar codes. The only suggestion for directing operation of an ATM with a software applet is found in Appellants' own novel disclosure. It follows that the alleged modification of Wagner (and the rejection) is based on hindsight reconstruction of the recited invention based on Appellants' disclosure, which is impermissible.

Also, the alleged modification to Wagner would destroy the disclosed and desired utility and operability of the Wagner teaching. The relied on feature of Russell is not compatible with the operation of Wagner. Wagner's operation is based on using an extended protocol, not software applets. An obviousness rejection cannot be based on a combination of features if making the combination would result in destroying the utility or advantage of the device shown in the prior art. *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988).

Furthermore, even if it were somehow possible to modify the system of Wagner with the teachings of Russell as alleged, such modification still would not result in the recited method. A modified Wagner still would not teach or suggest carrying out a portion of a banking transaction with a (ATM) transaction function device responsive to at least one software applet.

Neither Wagner nor Russell, taken alone or in combination, discloses or suggests the recited features, relationships, and steps. Therefore, it would not have been obvious to one having ordinary skill in the art to have modified Wagner with the teaching of Russell to have produced the claimed invention. The Action has not established a *prima facie* showing of obviousness.

CONCLUSION

Each of Appellants' claims meets the requirements of 35 U.S.C. § 112. The applied references do not constitute prior art to Appellant's invention. The cited Wagner reference does not provide an enabling disclosure. Also, as explained above, each of the pending claims specifically recites features, relationships, and/or steps that are neither disclosed nor suggested in the applied art. Furthermore, the applied art is devoid of any teaching, suggestion, or motivation for combining features of the applied art so as to produce the recited invention. For these reasons it is respectfully submitted that all of the pending claims are allowable.

Respectfully submitted,



Ralph E. Jocke
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000

Reg. No. 31,029

(viii)



CLAIMS APPENDIX

1. Apparatus comprising:

an automated banking machine, including:

an output device, wherein the output device outputs information, whereby
a user is enabled to perceive outputs from the output device;

an input device, wherein the input device is operative to receive inputs,
whereby a user is enabled to provide inputs to the machine;

a transaction function device, wherein the transaction function device is
selectively operative to carry out a transaction function;

a computer, wherein the computer is in operative connection with the
output device, the input device and the transaction function device;

software executable in the computer, wherein the software includes a browser, wherein the browser is operative to process HTML documents including instructions therein, and wherein the transaction function device is operative to carry out the transaction function responsive to the browser processing at least one document including at least one instruction adapted to cause the computer to cause operation of the transaction function device.

2. The apparatus according to claim 1 wherein the transaction function device includes a sheet dispenser.
3. The apparatus according to claim 1 wherein the transaction function device includes a card reader.
4. The apparatus according to claim 1 wherein the transaction function device includes a printer.
5. The apparatus according to claim 1 wherein the transaction function device includes a depository.

6. The apparatus according to claim 1 wherein the transaction function device includes a keyboard.
7. The apparatus according to claim 1 wherein the software is operative responsive to an instruction to access at least one HTTP record address, wherein the at least one HTTP record address corresponds to at least one HTTP record including instructions adapted to cause the computer to cause operation of the transaction function device.
8. An Automated Teller Machine (ATM) comprising:
 - a computer;
 - a browser operating in the computer;
 - a transaction function device in operative connection with the computer, wherein the transaction function device is operative to cause the ATM to carry out a transaction function responsive to at least one HTML format document that is received by the browser.

9. A method comprising the steps of:
- a) operating a browser in at least one computer in connection with an automated banking machine;
 - b) receiving at least one HTML format document with the browser, wherein the at least one HTML format document includes at least one transaction instruction;
 - c) carrying out at least one transaction function with a transaction function device in the automated banking machine responsive to the at least one HTML format document.
10. The method according to claim 9 wherein the automated banking machine includes an output device in operative connection with the computer, and further comprising the step of:
- d) producing an output through the output device responsive to the at least one HTML format document.
11. A method comprising the steps of:

- a) operating a browser in at least one computer in operative connection with an automated banking machine;
 - b) receiving at least one document with the browser, wherein the document includes at least one transaction instruction embedded therein;
 - c) carrying out at least one transaction function with a transaction function device in the automated banking machine responsive to the at least one document including the at least one transaction instruction.
12. An Automated Teller Machine (ATM) that operates to conduct at least one financial transaction responsive to at least one mark-up language document.
13. An automated banking machine comprising:
- a computer in operative connection with the banking machine;
 - at least one transaction function device in the banking machine adapted to carry out at least a portion of a banking transaction;

wherein the computer is adapted to cause at least one banking transaction to be carried out through operation of the at least one transaction function device responsive to at least one mark up language document.

14. The machine according to claim 13 wherein the computer includes document handling software, and wherein the computer is operative to carry out the at least one banking transaction responsive to the document handling software processing the at least one mark up language document.
15. The automated banking machine according to claim 13 wherein the transaction function device includes a note dispenser, and wherein the at least one banking transaction includes dispensing at least one note from the note dispenser.
16. A method comprising the steps of:
 - a) providing an automated banking machine including at least one transaction function device, wherein the automated banking machine is in operative connection with at least one computer;
 - b) processing at least one mark up language document with the computer;

- c) carrying out at least a portion of a banking transaction with the transaction function device responsive to processing the at least one mark up language document with the computer in step (b).
- 17. The method according to claim 16 wherein the transaction function device includes a note dispenser, and wherein in step (c) the portion of the banking transaction includes dispensing at least one note with the note dispenser.
- 18. The method according to claim 16 wherein the transaction function device includes at least one reader device, and wherein in step (c) the portion of the transaction includes reading indicia with the reading device.
- 19. The method according to claim 18 wherein the reading device includes a card reader, and wherein in step (c) indicia is read from a card.
- 20. The method according to claim 16 wherein the transaction function device includes at least one key, and wherein in step (c) the portion of the banking transaction includes sensing an input through the at least one key.
- 21. The method according to claim 16 wherein the transaction function device includes a depository, and wherein in step (c) the portion of the banking transaction includes receiving a deposit with the depository.

22. The method according to claim 16 wherein in step (a) the banking machine includes at least one output device, and further comprising the step of:
- d) providing at least one output through the output device responsive to processing at least one mark up language document with the computer.
23. The method according to claim 22 wherein the computer includes browser software, and wherein in step (d) the at least one output is provided responsive to the browser software processing the at least one mark up language document.
24. The method according to claim 23 wherein the output device includes a screen and wherein in step (d) the at least one output includes a visual output through the screen.
25. The method according to claim 16 wherein in step (b) at least one HTML document is processed by the computer.
26. The method according to claim 16 wherein the automated banking machine includes an output device, and wherein in step (c) processing the at least one mark up language document is operative to cause the computer to provide an output through the output device and to carry out at least the portion of the banking transaction.

27. The method according to claim 16 wherein the computer is operative to cause the carrying out of the portion of the banking transaction responsive to at least one software applet.
28. The apparatus according to claim 14 wherein the document handling software includes a browser, wherein the computer is adapted to automatically operate at least one transaction function device responsive to the processing of at least one mark up language document with the document handling software.
29. The apparatus according to claim 28 wherein at least one transaction function device includes a currency sheet dispenser, and wherein the banking transaction includes dispensing at least one currency sheet from the currency sheet dispenser.
30. The apparatus according to claim 13 and further including a display device having a display screen, wherein the computer includes document handling software, wherein the computer is operative to automatically display at least one visual output through the display device responsive to processing at least one mark up language document with the computer.

(ix)

EVIDENCE APPENDIX

Attached is Appellants' Declaration filed on February 4, 2002 pursuant to 37 C.F.R. § 1.131. The Declaration swears back prior to July 7, 1996.

The Office Action dated September 16, 2002 (at page 2, numbered paragraph 2) indicated that the Declaration filed February 4, 2002 was entered and considered. Later, the Declaration was further considered by the Board in the Decision (dated October 8, 2003; Appeal No. 2003-1651) regarding this application. The Board determined that the Declaration was sufficient to overcome the prior art rejections. For example, note the Decision at page 4, first full paragraph.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
Jay Paul Drummond, et al.)	
)	Art Unit: 2161
Serial No.: 09/193,787)	
)	
Filed: November 17, 1998)	Examiner: Jalatee Worjloh
)	
For: Automated Banking Machine)	
Apparatus And System)	

DECLARATION PURSUANT TO 37 C.F.R. § 1.131

Commissioner for Patents
Washington, D.C. 20231

Sir:

I, Jay Paul Drummond, hereby declare as follows:

1. At all times relevant hereto I was employed as Senior Principal Engineer with InterBold, a wholly owned subsidiary of Diebold, Incorporated ("Diebold") the Assignee of the above-identified patent application, and I am authorized on behalf of Diebold to present this Declaration.

2. I am also a joint inventor of the invention claimed in the above-identified patent application and have personal knowledge of the facts set forth herein. I am the sole inventor of the subject matter described and claimed in at least claims 1-4, 6-19, and 22-27 thereof.

3. At a time prior to July 7, 1996 in North Canton, Ohio, I conceived of an invention which was an automated banking machine, such as an automated teller machine ("ATM"), that would be connected to the Internet or to a private intranet. The ATM, including a computer, would operate to carry-out ATM transaction functions, such as the reading of customer cards such as debit cards and the dispense of sheets such as bank notes, in response to receiving Hypertext Markup Language ("HTML") documents by the ATM through either the Internet or a private intranet, or both. This idea was conceived of by myself in the course of my employment with InterBold, which is a wholly owned subsidiary of Diebold and is now also called Diebold Self-Service Systems.

4. After conceiving of this ATM invention, Dale Blackson, who was an engineering Director, and I had a meeting in North Canton, Ohio, prior to July 7, 1996 to discuss making an ATM in accordance with the invention. At that time InterBold was also working on a project called "MOSS" which was a project to be able to use multiple types of operating systems on the computer of an ATM, instead of only IBM OS/2 which was used on Diebold ATMs at that time. During our meeting Blackson and I discussed how this new ATM would use software that includes a browser to process documents, such as HTML documents, to provide the screen displays and control the transaction function devices in the ATM. After our meeting Blackson sent to me and others at InterBold the e-mail message attached as Exhibit A hereto. The dates in Exhibit A which have been deleted, are all prior to July 7, 1996.

5. Prior to July 7, 1996, Blackson, in his capacity as engineering Director, gave instructions for me to proceed with the development of a demonstration ATM system to prove that the new ATM concept would work.

6. Prior to July 7, 1996, I and other inventors at InterBold in North Canton, Ohio made an ATM which included a computer having a Microsoft Windows® operating system and Netscape® browser software. Prior to July 7, 1996 we developed a series of HTML documents in which processing of a certain number of the documents by the ATM caused the ATM to generate screen displays that guided a user in the operation of the ATM. We also included in HTML documents, embedded code which comprised instructions that caused operation of a card reader, a cash dispenser, and other transaction function devices included in the ATM.

7. Prior to July 7, 1996, I and other inventors at InterBold made and operated a system in North Canton, Ohio which included an HTTP server computer which delivered the series of HTML documents to the ATM. The server computer was connected to the ATM through a local TCP/IP intranet. The computer in the ATM included the Netscape® browser software, Microsoft Windows® software and other software written by myself and other inventors. This software on the ATM operated to produce the screen displays on the ATM in response to HTML documents processed by the browser to guide a user in operating the ATM. The software on the ATM also caused the card reader, cash dispenser and other devices in the ATM to operate in response to processing the HTML documents and the embedded code contained therein.

8. The system was tested prior to July 7, 1996 and was operated successfully to carry out reading data on a magnetic stripe card, cash dispensing and other transaction functions. The computer in the ATM operated to access network addresses associated with HTML documents on the HTTP server computer in response to data read from a card input to the card reader on the ATM. HTML documents accessed from the HTTP server computer generated display screens on the ATM, and the ATM dispensed currency notes from a bill dispenser in the ATM in response to instructions included in the HTML documents.

9. This testing which was conducted prior to July 7, 1996 was successful, and established that the invention that is claimed in at least claims 1-4, 6-19, and 22-27 in the above-referenced patent application would work for its intended purposes. For example, the system that was tested and operated successfully prior to July 7, 1996, operated in accordance with the method recited in claim 11 of the above-referenced patent application to:

- a) operate a browser in at least one computer in operative connection with an automated banking machine;
- b) receive at least one document, having at least one transaction instruction embedded therein, with the browser; and
- c) carry out at least one transaction function with a transaction function device in the automated banking machine responsive to the at least one document.

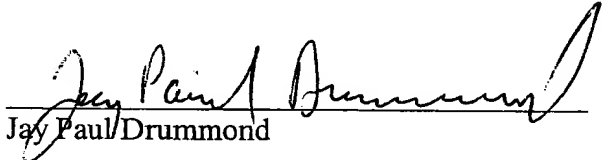
10. The testing described above in this Declaration which was conducted prior to July 7, 1996, was considered successful and permission to develop a commercial ATM product based on the invention was requested from Diebold management. A series of presentation screens was developed by the inventors for purposes of requesting the necessary resources to begin development of a commercial product based on the invention. These presentation screens were used as part of the presentation made to Alben W. Warf, Vice President of Diebold, prior to July 7, 1996. Copies of the presentation screens are attached hereto as Exhibits B-C. All dates deleted from Exhibits B-C are prior to July 7, 1996.

11. Authorization to develop a commercial product based on the invention was granted by Mr. Warf. This commercial product was successfully developed and the first version of this product was introduced at the 1996 Bank Administration Institute Retail Delivery Show after the

filing of U.S. Provisional Patent Application Serial Number 60/031,956 on November 7, 1996, from which the above-identified patent application claims priority.

12. As can be seen from Exhibits A-C, the invention claimed in the above-identified patent application was completed by being conceived and reduced to practice in the U.S. prior to July 7, 1996.

I hereby declare that all statements herein of my own knowledge are true and all statements made on information and belief are believed to be true, and further that the statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both (18 U.S.C. § 1001), and may jeopardize the validity of the application or any patent issuing thereon.


Jay Paul Drummond

1-23-02
Date

To: Mark Smith@9_53 FinanceSys@InterBold
 Cc: Pat Green@9_89 PPM@InterBold
 Brad Stephenson@9_89 PPM@InterBold
 Jim Block@9_52 SST Eng@InterBold
 Jay Drummond@9_53 FinanceSys@InterBold
 Bcc:
 From: Dale Blackson@9_53 FinanceSys@InterBold
 Subject: MOSS - your very simple demo application
 Date:
 Attach:
 Certify: N

Mark,

Jay and I briefly talked about our "forward looking" approach to ATM transactions. The HTML Internet approach sounds more and more intriguing.

Let's do it. Have someone on the team look into the available tools to do a simple demo. We don't want to spend a fortune on it at this stage, but let's at least explore the feasibility. Let's go beyond thinking about, do it.

What is "It" ?

Use Internet technology to implement the ATM transaction flow. No states & screens. User lead through is via HTML screens and hypertext. User sees a screen and touches what they want. Use this technique to get to the point where the transaction is specified. Send transaction data. Get function command as some sort of Internet file. An encrypted/authenticated file transfer that specifies the function command stuff.

Could be done over private Internet. Could be done over the public Internet.

Public Internet provides the connectivity to every place. Install an ATM and plug it into the net. Nothing could be easier? Bank is on Internet. When user does a transaction, they are connected to their bank or whoever is authorized to handle the need. Browse info, do transactions.

Of course there are security concerns. But we can be pretty sure that someone will solve this for us. There are now credit card transactions via Internet. There is enough security for now, and we can easily imagine it getting better.

Internet might be too slow or unpredictable now. Don't worry too much. Someone will provide the service we need. There will be a lot of people working on this. The bandwidth is here (coming?).

How's this for software distribution! The transaction flow, screen content, etc is not in the ATM. It is on the net. Can centrally change screen content and flow as needs require.

When you use an ATM away from home, it can have the same personality as your home ATM. The personality is not in the ATM. It is in the "home page" that your own bank has for your ATM functionality.

Do some brainstorming to develop an implementation approach. Find major holes and fill them. Don't worry too much about details. The technology is evolving and chances are it will catch up with our needs.

Give me some feedback. Include me in discussion sessions.

Thanks, Dale Blackson

PUT SELF SERVICE SYSTEMS ON THE INTERNET



Internet

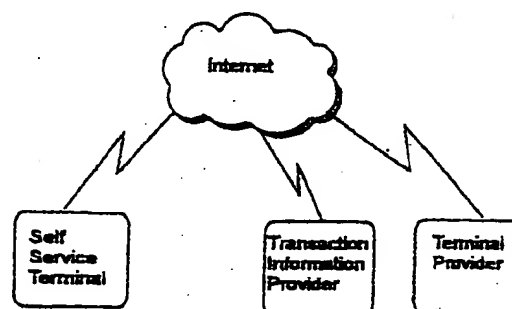
IT'S TIME TO TRY SOMETHING NEW

- ATM control and communications techniques were designed in the 1970's
- Internet provides worldwide connectivity
- Internet provides way to access multiple databases for information and control

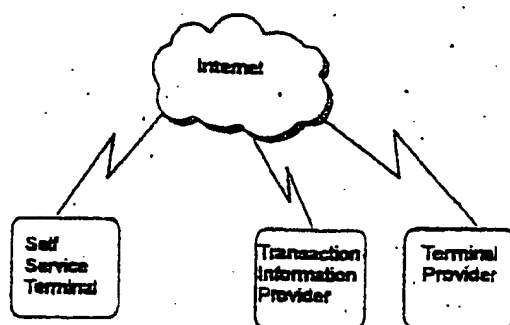
INTERNET HAS APPEAL

- Universal awareness
- Media attention (e.g. Netscape IPO)
- Marketing sizzle
- Technical capabilities
- Progressive approach
- Lots of innovations coming
- Bandwidth is available or coming
- Security is available or coming
- Just plug it in and go

USE INTERNET TO TRANSPORT THE INFORMATION



LET DIEBOLD TAKE THE LEAD



DIEBOLD PUTS SELF SERVICE TERMINALS ON THE INTERNET

- Diebold provides an alternative to current ATM network technology
- Diebold provides the Internet compatible self service terminals
- Diebold provides the Internet compatible "host" software nodes

STRATEGIC POTENTIAL

- Putting ATMs on the network establishes Diebold's in a new market
- Positions Diebold as a solution provider on the rapidly growing Internet
- Positions Diebold as a future provider of "electronic money" services

Transaction Lead-through

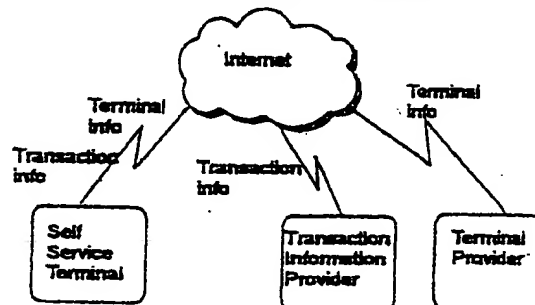
- Use Internet technology (HTML) to construct the user interface
 - User touches area of interest on display
 - Next related display panel is presented
- Send user's transaction info
 - Encrypted/Authenticated files
- Receive transaction command
 - Encrypted/Authenticated files



YOUR "HOME" ATM IS EVERYWHERE YOU GO

- The ATM personality is established for each user as they establish connections back to their own bank
- Banks can export their personality to every networked ATM
- ATM owners provide the appliance to do what the user and their bank want to do

Separate the Transaction Related Information from the Terminal Related Information



CONNECTIVITY TO EVERYWHERE

- Plug the terminal into the Internet
- Transaction information providers are on the Internet
 - To process the transaction information
- The terminal providers are on the Internet
 - To process equipment status
- User establishes connection to their preferred transaction provider

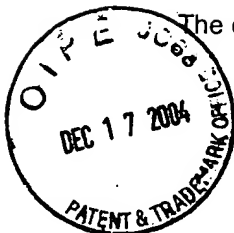
WE HAVE SOME STARTING POINTS

- MOSS project provides a suitable architecture
- This may be an interesting approach for our demo application
- Ideal approach for information browsing (i.e. kiosk applications)

(x)

RELATED PROCEEDINGS APPENDIX

Attached is a copy of the Board Decision (dated October 8, 2003) regarding Appeal No. 2003-1651, as identified in section (ii) of this Brief.

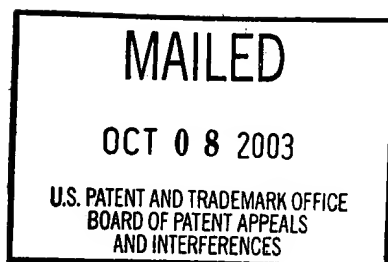


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



Ex parte JAY PAUL DRUMMOND et al.

Appeal No. 2003-1651
Application No. 09/193,787¹

ON BRIEF

Before ABRAMS, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection (Paper No. 18, mailed September 16, 2002) of claims 1 to 30, which are all of the claims pending in this application. On page 2 of the reply brief (Paper No. 22, filed April 18, 2003), the appellants noted that (1) they are willing to amend dependent claim 27 to include mutually agreeable language in order to overcome the sole rejection of claim 27 as

¹ Filed November 17, 1998. According to the appellants, the application claims benefit of provisional Application No. 60/031,956, filed November 27, 1996.

being indefinite under the second paragraph of 35 U.S.C. § 112; and (2) the rejection of claim 27 no longer appears to be an issue. Accordingly, we deem the appeal with respect to claim 27 to be withdrawn and we dismiss the appeal with respect to claim 27. Claims 1 to 26 and 28 to 30 remain on appeal.

We REVERSE.

BACKGROUND

The appellants' invention relates to automated banking machines (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The references of record relied upon by the examiner in rejecting the appealed claims are:

McLean	4,337,864	July 6, 1982
McMillan	5,436,435	July 25, 1995
Russell et al. (Russell)	5,905,248	May 18, 1999
Zeanah et al. (Zeanah)	5,933,816 ²	Aug. 3, 1999

² This patent issued from Application No. 08/908,413, filed August 7, 1997. This patent claims benefit of provisional Application No. 60/029,209, filed October 31, 1996.

Claims 1 to 6, 8-13, 16 and 22 to 26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Zeanah.

Claims 7, 14, 28 and 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Zeanah in view of Russell.

Claim 29 stands rejected under 35 U.S.C. § 103 as being unpatentable over Zeanah in view of Russell and McLean.

Claims 15 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Zeanah in view of McLean.

Claims 18 to 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Zeanah in view of McMillan.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 21, mailed March 11, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 20, filed January 17, 2003) and

reply brief (Paper No. 22, filed April 18, 2003) for the appellants' arguments thereagainst.

OPINION

The appellants assert (brief, pp. 11-24) that (1) Zeanah is not available as prior art under 35 U.S.C. § 102(e); and (2) the 37 CFR § 1.131 declaration of Jay Paul Drummond (Paper No. 13, filed February 4, 2002) is sufficient to overcome the prior art rejections under appeal. We agree.

The burden of establishing a prima facie case of anticipation resides with the examiner. See In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Likewise, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

It is the examiner's burden to establish that Zeanah is available as prior art under 35 U.S.C. § 102(e)³ with respect to the claims under appeal. This the examiner has not done.

³ 35 U.S.C. § 102(e) provides that a person shall be entitled to a patent unless the invention was described in a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent.

To establish that Zeanah is available as prior art under 35 U.S.C. § 102(e) with respect to the claims under appeal, the examiner must determine that the effective filing date of Zeanah is prior to the effective filing date of the claimed subject matter. Thus, the examiner must determine the effective filing date of Zeanah and the effective filing date of the claimed subject matter.

Zeanah is clearly entitled to at least an effective filing date of August 7, 1997. Zeanah is not entitled to an effective filing date of October 31, 1996 unless the provisional application (Application No. 60/029,209) discloses the claimed invention in the manner required by the first paragraph of 35 U.S.C. § 112.⁴ The examiner has not determined that provisional Application No. 60/029,209 discloses the claimed invention in the manner required by the first paragraph of 35 U.S.C. § 112. Accordingly, for purposes of this appeal, the examiner has only determined that Zeanah is entitled to an effective filing date of August 7, 1997.⁵

The appellants claim benefit back to provisional Application No. 60/031,956, filed November 27, 1996. To apply Zeanah as prior art under 35 U.S.C. § 102(e), the

⁴ See 35 U.S.C. § 119(e).

⁵ The examiner's position (answer, pp. 14-15) that due to the presumption of validity the patent to Zeanah is presumed to be entitled to the October 31, 1996 filing date of the provisional application is without merit.

examiner must also determine the effective filing date of the claimed subject matter (e.g., is the claimed subject matter entitled to an effective filing date of November 27, 1996). The examiner has not set forth the effective filing date of the claimed subject matter.⁶

Since the examiner has not established that the effective filing date of Zeanah is prior to the effective filing date of the claimed subject matter, the examiner has not established that Zeanah is available as prior art under 35 U.S.C. § 102(e).

In any event, even if Zeanah was available as prior art under 35 U.S.C. § 102(e) with an effective filing date of October 31, 1996, the appellants submit that the Drummond declaration establishes reduction to practice of the subject matter of claims 1-4, 6-19 and 22-27 prior to July 7, 1996, thus overcoming the prior art rejections of claims 1-4, 6-19 and 22-27. The appellants admit (brief, p. 15) that the differences between claims 5, 20, 21 and 28 to 30 and claims 1-4, 6-19 and 22-27 would have been obvious to one of ordinary skill in the art. Thus, the appellants argue that the prior art rejections of claims 5, 20, 21 and 28 to 30 is also overcome by the Drummond declaration.


⁶ The appellants assert that the effective filing date of the claimed subject matter is November 27, 1996.

The examiner's sole expressed objection to accepting the Drummond declaration (answer, pp. 17-18) is that it is not signed by all the joint inventors of the claims under rejection (i.e., claims 1 to 26 and 28 to 30). However, this objection is not a proper basis for refusing to accept the Drummond declaration since that declaration is signed by the inventor of the subject matter of claims 1 to 4, 6 to 19 and 22 to 27). 37 CFR § 1.131 permits such a declaration to be signed by less than all of the inventors.


Since the examiner has not proffered any valid objection as to why the Drummond declaration does not establish a reduction to practice of the subject matter of claims 1-4, 6-19 and 22-27 prior to July 7, 1996, the Drummond declaration must be accepted by us as sufficient to overcome the prior art rejections under appeal.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 6, 8-13, 16 and 22 to 26 under 35 U.S.C. § 102(e) is reversed and the decision of the examiner to reject claims 7, 14, 15, 17 to 21 and 28 to 30 under 35 U.S.C. § 103 is reversed.

To summarize, the decision of the examiner to reject claims 1 to 6; 8-13, 16 and 22 to 26 under 35 U.S.C. § 102(e) is reversed and the decision of the examiner to reject claims 7, 14, 15, 17 to 21 and 28 to 30 under 35 U.S.C. § 103 is reversed.


NEAL E. ABRAMS
Administrative Patent Judge


JOHN P. McQUADE
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

Appeal No. 2003-1651
Application No. 09/193,787

Page 9

RALPH E. JOCKE
231 SOUTH BROADWAY
MEDINA, OH 44256

JVN/jg

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